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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056509
Party	Defendant 3D Systems, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Registrant: 3D Systems, Inc.
Mark: 3DS & Design
Reg. No.: 4,125,612 in Classes 1, 7, 9 and 40
Registered: April 10, 2012

)	
Autodesk, Inc.)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92056509
)	
3D Systems, Inc.,)	
)	
Respondent)	

RESPONDENT’S MOTION TO COMPEL DISCOVERY

3D Systems, Inc., (“Respondent” or “3D Systems”) moves pursuant to 37 C.F.R. § 2.120(e) and Rule 37(a) of the Federal Rules of Civil Procedure to compel Autodesk, Inc. (“Petitioner” or “Autodesk”) to: (1) produce all relevant documents and information regarding Petitioner’s use of the term “3DS” as a file extension; (2) produce all relevant documents in response to Respondent’s first and second sets of Requests for Production to which Petitioner agreed to produce; and (3) provide a sufficient privilege log.

I. Background Facts and Procedural Posture

Petitioner initiated this cancellation proceeding on November 29, 2012, challenging Respondent’s U.S. Trademark Registration No. 4,125,612 for 3DS & Design on the basis of priority and likelihood of confusion and dilution in favor of Autodesk’s 3DS MAX designation.¹ Over the next year, the parties requested various extensions of time to accommodate settlement

¹ Petitioner later consented to dismissal of its dilution claim; hence the only remaining issues are priority and likelihood of confusion. *See* TTABVue 12, 13.

negotiations that were ongoing. *See, e.g.*, TTABVUE 8, 10, 15, 17. In the fall of 2013, Respondent served discovery requests on Petitioner, and shortly thereafter, Petitioner filed a motion to extend (without consent) seeking extension of the remaining deadlines in the proceeding by 90 days, and a 40 day extension of time to respond to discovery requests served by 3D Systems on Autodesk. *See* TTABVUE 20. On March 18, 2014, the parties filed a consent motion to a further extend the remaining deadlines in the proceeding, and the motion was granted on April 12, 2014, in an order noting that no further requests to extend the close of discovery would be granted. *See* TTABVUE 23, 24.

On January 17, 2014, 3D Systems served responses to Autodesk's discovery requests, and on January 27, 2014, Autodesk served its discovery responses on 3D Systems. On March 18, 2014, having reviewed Autodesk's discovery responses, but not received any document production, Jason Sneed, Counsel for 3D Systems, wrote to John Slafsky, Counsel for Autodesk, outlining multiple deficiencies in Autodesk's discovery responses, and requesting a discovery conference during the week of March 24th to discuss. Exhibit 1, at pp. 1-5. Specifically, Counsel for Respondent highlighted Petitioner's failure to respond to a number Requests for Production asking for documents relating to trademark registrations containing the term "3DS" as well as any advertising and marketing materials detailing the use of Petitioner's 3DS MAX designation. Exhibit 1, at p. 5.

On March 28, 2014, Mr. Slafsky wrote to Mr. Sneed outlining perceived deficiencies in 3D Systems' discovery responses, but completely failing to acknowledge Mr. Sneed's letter of March 18th, or responding in any way to Mr. Sneed's request for a discovery conference during the week of March 24th. Exhibit 2. The parties eventually agreed to hold a meet and confer on

May 2nd, and, unable to address all the issues of both parties during that call, the call was continued on May 6th.

During the meet and confer, Counsel for both parties withdrew certain objections, agreed to supplement or amend certain discovery responses, maintained certain objections, and agreed to produce documents. Counsel for Respondent also—upon request by Petitioner’s Counsel and to resolve Autodesk’s objections—clarified Respondent’s Requests for Admissions concerning the use of “3DS” as a file extension. On June 7, 2014, Counsel for Respondent sent a letter summarizing the discovery conference of May 2nd and May 6th and identifying outstanding deficiencies with respect to Petitioner’s discovery responses that Counsel for Petitioner agreed to supplement, including but not limited to providing a representative sample of Petitioner’s advertising and marketing materials as well as documents sufficient to identify any advertising agencies used to promote the 3DS MAX brand. Exhibit 3, at pp. 2-3. No production was made by Petitioner until June 27, 2014.

When Counsel for Respondent had not received any supplemented or amended discovery responses from Petitioner, despite Petitioner’s commitment to provide such responses nearly three months prior, Counsel for Respondent again wrote to Counsel for Petitioner on August 5, 2014, requesting a meet and confer before August 13, 2014 “to discuss the remaining deficiencies and to satisfy our obligation under Fed. R. Civ. P. 37(a)(1) and 37 C.F.R. § 2.120(e)(1) to make a good faith effort to resolve these issues prior to filing a Motion to Compel.” Exhibit 4, at p. 1. However, in response to Respondent’s letter, rather than agreeing to meet and confer, Petitioner merely filed its own Motion to Compel, and proceedings were suspended shortly thereafter, precluding Respondent from taking further action.² TTABVUE 25

² This suspension does not excuse Petitioner’s failure to respond to Respondent’s outstanding discovery requests served prior to Petitioner filing its motion. TBMP § 510.03(a).

and 26. It was not until August 7, 2014, after Counsel for Respondent served its second set of discovery requests on Petitioner, that Petitioner produced its supplemental responses to Respondent's first set of discovery requests agreeing to produce non-privileged documents responsive to the requests discussed during the parties' meet and confer on May 2nd and 6th. Exhibit 5, at pp. 4-6. Then on September 10, 2014, Petitioner finally responded to Respondent's second set of discovery requests by agreeing to also produce documents response to these requests. Exhibit 6, at pp. 4-6. Yet to date, no such production has been made.

Given Petitioner's continued delay and failure to provide meaningful discovery, despite having committed to do so, Respondent seeks judicial intervention to compel Petitioner to respond to Respondent's First and Second Sets of Interrogatories and Requests for Production and Respondent's First Set of Requests for Admission, including specifically the production of documents and information concerning Petitioner's use of the term "3DS" as a file extension. The Board should also compel Petitioner to produce the documents that Petitioner agreed to supplement more than two months prior, and, to the extent that the Board's Order of October 30, 2014, terminated Respondent's discovery period, the Board should reopen the discovery period to allow Respondent to complete the discovery process.

II. Argument

A. Information and Documents Regarding the ".3ds" File Extension is Relevant to the Strength and Functionality of Autodesk's 3DS MAX Designation and Should be Produced

Petitioner's refusal to produce key information and documents pertaining to the use of the term "3DS" as a file extension in Autodesk's software sold under its 3DS MAX designation is without merit as this evidence is directly relevant to the inherent strength of Autodesk's trademark—a factor used in determining likelihood of confusion by taking into account the

“nature of the mark itself”. *See, e.g., Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, *18-19 (TTAB 2014) (noting that “the inherent strength of a mark [is] a factor relevant to the likelihood of confusion” analysis by helping to measure the distinctiveness of a mark.).

Petitioner believes, consistent with the recent E.D.Va decision in *Autodesk, Inc. v. Michelle K. Lee* which upheld the USPTO’s refusal to register the mark DWG on the grounds that it was merely descriptive, that Autodesk’s use of the term “3DS” in its 3DS MAX designation describes software that works, or is compatible, with .3ds formatted files. *See* Exhibit 7, at p. 6. This alone deems Autodesk’s 3DS MAX designation, at best, a descriptive mark as it merely describes an attribute of Autodesk’s 3DS MAX software and does not serve to identify the source of Autodesk’s goods or services. As such, the information Respondent seeks regarding Autodesk’s use of the .3ds file extension in its software sold under the 3DS MAX designation is directly and undeniably related to Respondent’s defenses in this proceeding.

Information regarding Petitioner’s use of the term “3DS” as a file extension also sheds light on whether or not Autodesk’s 3DS MAX designation has a functional purpose, which, if shown, would negate any claimed trademark rights in Autodesk’s 3DS MAX designation, as a trademark with a functional purpose “cannot receive trademark protection”. *AS Holdings, Inc. v. H&C Milcor, Inc., F/K/A Aquatico of Texas, Inc.*, 107 USPQ2d 1829, at *4 (TTAB 2013). Here, Petitioner believes that Autodesk’s use of the term “3DS” is functional – specifically, the term “3DS” in the asserted 3DS MAX registration operates to identify the file format in which files created by the 3DS MAX software are saved. The 3DS MAX designation would be devoid of protection as a trademark if Respondent can show that “3DS MAX” does not identify an Autodesk product but instead identifies the fact that the software sold in connection with the 3DS

MAX designation is compatible with .3ds formatted files. *See e.g. Autodesk Inc. v. Dassault Systemes Solidworks Corp.*, 3:08-cv-04397-WHA, at *6 (N.D. Cal. Dec. 31, 2009) (“The primary function of a file extension to both a computer and its user is to identify a file or file type”, and “[e]ven if the function were solely to identify the format in which the contents are stored, that would still be a functional use.”).

Moreover, Respondent contends that Petitioner has waived its objections as to the production of documents and things relating to Autodesk’s use of the “.3ds” file extension by responding to Respondent’s Interrogatory asking Autodesk to “[d]escribe the nature of the “.3ds” filename extension”. Exhibit 8, at p. 15. Petitioner also previously agreed to produce a witness to testify about the adoption of the “.3ds” file extension. Exhibit 8, at p. 14. As such, it is sheer gamesmanship to now refuse to answer Respondent’s discovery requests asking Petitioner for information and documents relating to the use of the term “3DS” as a filename extension. Petitioner likewise cannot now object to producing information and documents regarding Autodesk’s knowledge of the “.3ds” file extension and any products sold or marketed which are capable of saving files using the “.3ds” file extension.

Accordingly, Petitioner should be ordered to: (1) provide substantive interrogatory responses, in full, to Interrogatory Nos. 26 and 27; (2) produce all documents responsive to Requests for Production Nos. 12, 46 and 49; and (3) admit or deny Requests for Admission Nos. 1, 2, and 7.

B. Petitioner Must Produce Documents in Response to Respondent’s Requests for Production For Which Petitioner Has Agreed to Produce

Respondent has not received any additional production from Petitioner since its initial production on June 27, 2014, despite Petitioner agreeing to “produce non-privileged documents responsive to [Respondent’s Requests for Production] that can be located after a reasonable

search.” Exhibit 5, at pp. 4-6 and Exhibit 6, at pp. 4-6. It has now been over four months since Petitioner’s Counsel first made these promises, and as such, there exists no reason for Petitioner’s failure to perform a reasonable search and produce documents responsive to these requests. Accordingly, Petitioner should be ordered to produce all documents responsive to Respondent’s Requests for Production Nos. 7, 9, 10, 14, 15, 17, 48, 50, 51 and 52.

1. Marketing and Advertising Documents, Including the Identity of Any Advertising Agency Used by Petitioner, are Relevant and Discoverable under TBMP § 414(17)

Respondent’s Requests for Production Nos. 14 and 15 seeking documents “sufficient to show each use...of the 3DS MAX designation in conjunction with the promotion or provision of the products and/or services of Autodesk” and “referring or relating to any communication with any advertising agency...” are standard requests, wholly relevant to this proceeding. *See* TBMP § 414(17). In fact, Autodesk’s Counsel acknowledged the relevancy of Respondent’s requests during the meet and confer in early May, and again in Petitioner’s supplemental discovery responses, when Counsel for Petitioner agreed to produce responsive documents, including documents sufficient to identify any advertising agencies and substantive communications therewith regarding the promotion, advertising and marketing of the 3DS MAX brand. Exhibit 3, at p. 3 and Exhibit 5, at pp. 5-6. Yet Petitioner still has not produced any such documents. Accordingly, Petitioner should be ordered to produce all documents responsive to Respondent’s Requests for Production Nos. 14 and 15.

2. Documents Concerning Petitioner’s Enforcement and Licensing Efforts are Relevant and Discoverable under TBMP § 414(10)

The material requested in Respondent’s Request for Production Nos. 7 and 9 is discoverable as it contains information concerning litigation and controversies between Petitioner and third parties based on the Petitioner’s 3DS MAX designation. *See* TBMP §

414(10) and n.17. Specifically, Respondent seeks documents referring or relating to Autodesk's licensing and enforcement of any trademark registrations containing the term "3DS" as well as documents sufficient to show the identity of Autodesk's licensees relating to the 3DS MAX designation. To the extent that these documents contain provisions governing the use or non-use of the 3DS MAX designation, they are likely to lead to the discovery of admissible evidence and should be produced. And once again, as a result of the parties' meet and confer efforts in early May, Counsel for Petitioner agreed to produce documents responsive to these requests, including a representative sample of documents sufficient to show the categories of licensees. Exhibit 3, at p. 2 and Exhibit 5 at pp. 4-5. Yet Petitioner has failed to do so. Accordingly, Petitioner should be ordered to produce all documents responsive to Respondent's Requests for Production Nos. 7 and 9.

3. Information Concerning Petitioner's Awareness of Third Party Use is Relevant and Discoverable under TBMP § 414(9)

Respondent's Request for Production Nos. 10, 48, 50 and 51 go to the issue of whether Autodesk has protectable rights in the 3DS MAX designation, which is centrally at issue in this proceeding, and this information is routinely discoverable in TTAB proceedings. *See e.g.*, TBMP § 414(9) ("Information concerning a party's awareness of third-party use and/or registration of the same or similar marks...is discoverable..."). For example, Respondent requests production of documents relating to third party use of trademarks or trade names containing the term "3DS", the marketing and promotion associated with such third party use, and Autodesk's subsequent awareness of the same. If Petitioner has actual knowledge of this information, it must produce documents relating to such awareness. *See e.g.*, TBMP § 414(9). Still further, Counsel for Petitioner agreed to produce documents responsive to these requests during the parties' meet and confer efforts and in Counsel for Petitioner's Responses to Respondent's Second Set of Requests

for Production, but has failed to do so to date. Exhibit 3, at p. 2 and Exhibit 6, at pp. 4-6.

Accordingly, Petitioner should be ordered to produce all documents responsive to Respondent's Requests for Production Nos. 10, 48, 50 and 51.

4. Documents Concerning the Similarity or Dissimilarity of the Marks at Issue are Relevant and Discoverable as a Factor in Determining Likelihood of Confusion

The information requested in Respondent's Request No. 17 concerning comparisons between the marks at issue in this cancellation proceeding is clearly relevant as the "similarity or dissimilarity of the marks in their entireties" is the first factor in determining whether there exists a likelihood of confusion between Petitioner's 3DS MAX designation and Respondent's 3DS & Design mark. *See e.g., In re E.I. du Pont de Nemours & Co*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Counsel for Petitioner acknowledged the relevancy of this request during the meet and confer in early May when it agreed to produce non-privileged documents responsive to this request. Exhibit 3, at p. 2. Yet to date, no such production has been made. Accordingly, Petitioner should be ordered to produce all documents responsive to Respondent's Requests for Production No. 17.

5. Petitioner Must Produce Information It Relied on or Referred to in Responding to Respondent's Discovery Requests

Finally, Petitioner has yet to produce information referred to or relied on in responding to Respondent's Second Set of Interrogatories to Petitioner and Respondent's Second Set of Requests for Admissions to Petitioner despite articulating that it "will produce non-privileged documents responsive to this request that can be located after a reasonable search." Exhibit 6, at p. 6. Accordingly, Petitioner should be ordered to produce all documents responsive to Respondent's Requests for Production No. 52.

C. Petitioner Must Produce a Proper Privilege Log Adequately Describing Petitioner's Reasons for Withholding Production

Petitioner has provided an inadequate privilege log in violation of its duties under the Federal Rules of Civil Procedure 26(b)(5) by failing to include sufficient descriptions allowing Respondent to assess the applicability of privilege. *See No Fear, Inc. v. Ruede D. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (“[A]ny claim that otherwise responsive documents are privileged requires a ***particularized explanation*** of the privilege relied on, and a description of the documents which, without revealing the privileged information, is sufficient to allow the inquiring party to assess the applicability of privilege.” (emphasis added)). Petitioner even acknowledged in its own Motion to Compel that “a party making a claim of privilege must do so expressly and otherwise describe the nature of the documents, communications, or things not produced or disclosed in a manner enabling the other party to assess the applicability of the claim or privilege....” *Red Wing Co. v. J.M. Smucker Co.*, 58 USPQ2d 1861, 1864 n.5 (TTAB 2001); *See* TTABVUE 25, at pp 12-13.

However, on August 7, 2014, Petitioner produced a privilege log in which Petitioner's Counsel describes its reasoning for withholding production in all 51 entries as simply “outside counsel legal advice to company.” Exhibit 9. In failing to include even the most minimal description of the topic with which Petitioner seeks protection, Petitioner completely disregards Rule 26(b) of the Federal Rules of Civil Procedure requiring:

[A] party withholding discovery documents under a claim of privilege to ‘describe the nature of the documents, communications, or tangible things not produced or disclosed—and to do so in a manner that, without revealing information itself privilege or protected, will enable other parties to assess the claim.’

Avgoustis v. Sinseki, 639 F.3d 1340, 1345-46 (Fed. Cir. 2011) (quoting Fed. R. Civ. P.

26(b)(5)(A)(ii)). Further, “[t]he advisory committee notes...explain that ‘details

concerning...general subject matter...may be appropriate.” *Id.* (quoting Fed. R. Civ. P. 26(b)(5)(A)(ii) advisory committee’s note (1993)). This “requirement to disclose general subject matter in a privilege log” does not “invalidate the attorney-client privilege [since] the purpose of the rule is to determine whether the document is privileged ‘without revealing information itself privileged or protected.’” *Id.* at 1346 (quoting Fed. R. Civ. P. 26(b)(5)(A)(ii)).

Here, Petitioner’s privilege log fails to provide the requisite subject matter to which outside counsel provided legal advice to Autodesk. As such, the Board should compel Petitioner to provide a proper privilege log adequately detailing the reasoning for withholding production. If not provided, privilege should be deemed waived and all documents so withheld ordered produced.

D. Respondent Should be Allowed Time to Review and Follow Up on Materials Produced by Petitioner Pursuant to this Motion

On a recent teleconference between Counsel for the Parties, Counsel for Petitioner took the position that the discovery period for Respondent had closed. Respondent respectfully submits that, to the extent that the Board’s Order of October 30, 2014, terminates Respondent’s ability to take and follow-up on discovery, the discovery period should be reopened. On August 7, 2014, at the time Petitioner’s Motion to Compel was filed, and with more than two weeks left in the discovery period, Respondent was about to file its own Motion to Compel; however, Petitioner’s Motion to Compel caused the proceedings to be suspended pursuant to 37 C.F.R. § 2.120(e)(2), and Respondent was unable to file any papers with the Board that were not germane to Petitioner’s motion, including the instant motion to compel. It is manifestly unfair that Respondent should be prevented from completing discovery by Petitioner’s premature motion to compel and continued refusal to produce documents. Thus, to the extent that the Board’s Order of October 30th terminates Respondent’s ability to conduct discovery, Respondent respectfully

requests that the discovery period be reopened to permit it to complete its discovery in this matter.

III. Conclusion

Petitioner has (1) failed to answer, or provide meaningful answers, to a number of discovery requests propounded by Respondent regarding Autodesk's use of "3DS" as a file extension, (2) failed to produce documents in which Counsel for Petitioner has agreed to produce, and (3) failed to provide a sufficient privilege log under the rules. Respondent has diligently attempted to resolve these problems without Board intervention, having met and conferred with Petitioner's Counsel and having suggested another opportunity to meet and confer with which Counsel has failed to acknowledge. Despite these efforts and repeated extensions of the deadline for discovery, Petitioner refuses to supplement its answers or produce documents responsive to the most basic kinds of discovery requests. For these reasons, and the other foregoing reasons, Respondent respectfully requests that the Board grant Respondent's Motion to Compel in its entirety.

Dated: December 13, 2014

Respectfully Submitted,

/s/ Jason M. Sneed

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Certificate of Filing / Certificate of Service

The undersigned hereby certifies that the foregoing *Respondent's Motion to Compel* was filed via ESTTA, and that a copy was placed in U.S. Mail, postage prepaid, addressed to the following counsel of record:

John L. Slafsky
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, California 94304-1050
Attorneys for Petitioner Autodesk, Inc.

This the 13th day of December, 2014.

/s/ Jason M. Sneed
An Attorney for Respondent

Exhibit 1

March 18, 2014

via U.S. Mail and email

John L. Slafsky, Esq.
Wilson Sonsini Goodrich & Rosati LLP
650 Page Mill Road
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Re: *Autodesk, Inc. v. 3D Systems, Inc.*, Trademark Trial and Appeal Board
Cancellation No. 92056509

Dear John:

Respondent has completed its initial review of Petitioner Autodesk, Inc.'s Responses to Respondent 3D Systems, Inc.'s First Set of Requests for Admission; Petitioner Autodesk, Inc.'s Responses to Respondent 3D Systems, Inc.'s First Set of Requests for the Production of Documents and Things; and Petitioner Autodesk, Inc.'s Responses to Respondent 3D Systems, Inc.'s First Set of Interrogatories. Autodesk's responses are deficient and incomplete in a number of respects, as detailed below. This letter is notice to you of these deficiencies and to ask Autodesk to remedy those deficiencies through amendment and/or supplementation, and to request a conference to discuss these deficiencies, in satisfaction of Respondent's obligations under 37 C.F.R. § 2.120(e)(1).

Respondent's Interrogatories to Autodesk

As an initial matter, Autodesk served its interrogatory responses without a signed verification, as required by Fed. R. Civ. P. 33(b)(3) and (5). Please provide a signed verification page that clearly indicates the identity of the person making responses on Autodesk's behalf.

In addition, Autodesk's responses are deficient, substantively, as follows:

Interrogatory No. 1: The response to Interrogatory No. 1 identifies only one individual, instead of the three requested by 3D Systems. We do not believe that identifying three individuals that are most knowledgeable about the use of the 3DS MAX mark is unduly burdensome. Please supplement your response.

Interrogatory No. 2: The answer to Interrogatory No. 2 is insufficient. If Autodesk opts to answer an Interrogatory by referring to business records pursuant to Fed. R. Civ. P. 33(d), Autodesk must specify the documents "in sufficient detail to enable the interrogating party to locate and identify them" and give 3D Systems a "reasonable opportunity to examine and audit the records." Fed. R. Civ. P. 33(d)(1) and (2). Autodesk has not met its burden pursuant to Fed. R. Civ. P. 33(d), and we thus insist that Autodesk amend or supplement its response to this Interrogatory to either provide a substantive response, or the information required pursuant to Fed. R. Civ. P. 33(d).

Interrogatory No. 5: The response to Interrogatory No. 5 is incomplete and grossly insufficient. The interrogatory clearly asks Autodesk to identify with particularity “each different type of product and service ever offered for sale or sold in the United States by Autodesk (or its Licensees) under the 3DS MAX Mark,” and for each such product or service, to provide additional information. Autodesk’s response identifies not one product or service sold under the 3DS MAX Mark, and instead provides an extensive list of marks “containing the 3DS MAX Mark” under which it has offered for sale “computer software for animating, modeling and rendering images.” Moreover, Autodesk has provided no response to subparts (v) and (vi) of the Interrogatory. Furthermore, Autodesk has not completely answered subpart (iii), which requests “the classes or types of customers...who purchase...each such type of product or service” – instead, Autodesk responds that the “classes of consumers...*include* developers of computer games and films as well as motion graphic artists” (emphasis added). This Interrogatory seeks standard information for a proceeding of this type, and Autodesk has no basis on which to object to the production of information sought by subparts (v) and (vi) given the protective order in place in this proceeding. *See, e.g.*, TBMP § 414(18). Please supplement your response immediately.

Interrogatory No. 6: The response to Interrogatory No. 6 identifies only one individual, instead of the three requested by 3D Systems. We do not believe that identifying three individuals that are most knowledgeable about the sales and distribution of products or services sold by Autodesk in connection with the 3DS MAX mark is unduly burdensome. Please supplement your response.

Interrogatory No. 7: Autodesk’s refusal to answer Interrogatory No. 7 is baseless and inappropriate. The Interrogatory seeks information regarding Autodesk’s fact witnesses, and making an objection based on privilege is without justification. Please supplement your response.

Interrogatory No. 10: Autodesk’s refusal to answer Interrogatory No. 10 is again baseless and inappropriate. The Interrogatory seeks information regarding the use of any marks incorporating the term “3DS” by third parties, and is wholly relevant to questions at issue in this proceeding. *See, e.g.*, TBMP § 414(9). With respect to Autodesk’s objection that the Interrogatory “seeks information related to uses of marks...that occurred outside the United States,” 3D Systems is willing to restrict the information sought by this Interrogatory to uses of marks incorporating the term “3DS” within the United States. Please supplement your response.

Interrogatory No. 12: The response to Interrogatory No. 12 identifies only one individual, instead of the three requested by 3D Systems. We do not believe that identifying three individuals that are most knowledgeable about Autodesk’s enforcement of the rights it claims in the 3DS MAX Mark is unduly burdensome. Please supplement your response.

Interrogatory No. 13: Autodesk’s refusal to answer Interrogatory No. 13 is without basis. The Interrogatory seeks information regarding any actual or purported association or confusion between Autodesk and/or its products and services sold in connection with the 3DS MAX Mark, on the one hand, and 3D Systems and/or its products and services sold in connection with the 3DS and Design mark, on the other. The information sought by this Interrogatory goes to the question of likelihood of confusion, which is the central issue in this proceeding. The

Interrogatory does not call for legal conclusions, and Autodesk's objection in this regard is inapposite. Moreover, this proceeding has been ongoing for more than a year. Autodesk's objection that "its investigation is ongoing, and accordingly it is premature to respond to this request" is wholly without basis. Please supplement your response immediately to provide the requested information.

Interrogatory No. 14: Autodesk's objections to this Interrogatory seeking the identity of persons most knowledgeable about "the adoption or use of the 3DS & Design Mark by 3D Systems" as well as a description of "the circumstances under which Autodesk first became aware of the 3DS & Design Mark" are, again, without basis. As an initial matter, the mere identity of persons knowledgeable about the information sought by this Interrogatory are not subject to the attorney-client privilege and/or work product doctrine. Moreover, information concerning the selection and adoption of a mark is discoverable, as are the names and addresses of a Party's officers. *See, e.g.*, TBMP § 414(4) and (12). Autodesk has no basis to refuse to answer this Interrogatory in its entirety. Please supplement your response to this Interrogatory immediately to provide the requested information.

Interrogatory No. 15: This Interrogatory specifically seeks "each and every *factual basis* for Autodesk's contention that the 3DS MAX Mark is confusingly similar to the 3DS & Design Mark" (emphasis added). Autodesk's objection that it "calls for legal conclusions" is thus wholly inappropriate. Moreover, Autodesk's objection that "its investigation is ongoing, and accordingly it is premature to respond to this request" is without basis. As a reminder, this proceeding has been ongoing for more than a year, which is ample opportunity for Autodesk to have investigated its factual bases for bringing this cancellation. Accordingly, we request that you supplement your response to this Interrogatory without further delay.

Interrogatory No. 16: As an initial matter, Autodesk's objection on the grounds that this Interrogatory "calls for disclosure of highly sensitive commercial information and/or trade secrets" is without basis given the protective order in force in this proceeding. Moreover, Autodesk's response that it "does not track annual marketing and promotion expenditures data by product or service, such as those under the 3DS MAX Mark" is inapposite. Such information is routinely discoverable in proceedings such as this one. *See, e.g.*, TBMP § 414(18). Autodesk may identify documents from which the information requested by this Interrogatory can be ascertained, or it may undertake the burden of doing so itself, but it is not relieved of its burden of answering this Interrogatory merely because it does not track certain information. Please supplement your response accordingly.

Interrogatory No. 17: The response to Interrogatory No. 17 identifies only one individual, instead of the three requested by 3D Systems. We do not believe that identifying three individuals that are most knowledgeable about the "advertising and promotion of goods and services offered by [Autodesk] under the 3DS MAX Mark" is unduly burdensome. Please supplement your response.

Interrogatory No. 20: Autodesk's refusal to answer this Interrogatory is without basis. Autodesk has refused to identify *a single person* "most knowledgeable about the creation, selection and decision by Autodesk...to adopt the 3DS MAX Mark, and identify all documents related to the creation, selection and adoption" of that mark. The information sought by this

Interrogatory is at the heart of the issues of this proceeding, and is discoverable. *See, e.g.*, TBMP § 414(4). Autodesk's apparent assertion that this information is, in its entirety, protected by privilege, is simply not credible or acceptable. Please supplement your response without further delay.

Interrogatory No. 22: The response to Interrogatory No. 22 identifies only one individual, instead of the three requested by 3D Systems. We do not believe that identifying three individuals that are most knowledgeable about the "adoption of ".3ds" as a filename extension by Autodesk" is unduly burdensome. Please supplement your response.

Interrogatory No. 25: Autodesk's refusal to answer this Interrogatory is untenable. As detailed below, Autodesk has refused to answer two of the three Requests for Admission propounded by 3D Systems, and has denied the third. As grounds for its refusal to respond, Autodesk objects to the Interrogatory as "compound" and seeking information protected by the attorney-client privilege and/or work product doctrine. Both of these objections are unfounded, and do not excuse Autodesk from its obligation to answer. The Requests for Admission propounded by 3D Systems are relevant, as discussed in further detail below, and Autodesk is obliged to answer this Interrogatory, and provide the information requested. Please supplement your response accordingly.

Respondent's Requests for Admission to Autodesk

As noted above, the responses of Autodesk to Respondent's Requests for Admission are deficient in the following respects:

RFA Nos. 1 and 2: Autodesk's refusal to answer these Requests is without basis. Autodesk objects on the grounds that these Requests are "vague and unintelligible," but does not identify the specific part of the Requests to which it contends this objection applies. Moreover, Autodesk's objection that these Requests are "not calculated to lead to the discovery of admissible evidence" is unfounded. Both of these Requests go to the issue of whether Autodesk has protectable rights in the 3DS MAX Mark, which is undoubtedly relevant to the claims and defenses in this proceeding. Autodesk has demonstrated that it knows how to respond to requests that it claims are "vague and unintelligible" as it responded to multiple Interrogatories and Requests for Production to which it made identical objections. While 3D Systems does not believe a meet and confer is necessary for Autodesk to answer these Requests, it will make itself available for such a meet and confer if required.

Respondent's Requests for Production to Autodesk

To date, Autodesk has not produced any documents to Respondent, despite its undertaking to do so. Respondent is thus unable, at this time, to comment on the sufficiency of Autodesk's document production. With respect to Autodesk's responses to 3D Systems' Requests for Production, 3D Systems notes that they are deficient in the following respects:

RFP No. 7: Autodesk, in response to this Request, objects on the grounds that it is "vague and ambiguous," but does not specify the language that it claims to not understand. While 3D Systems does not believe that the Request is unintelligible, 3D Systems is willing to meet and confer with Autodesk in order to clarify this Request, if required.

RFP No. 9: Autodesk objects to this Request on the grounds that it is unduly burdensome, and states that it has “entered into thousands of agreements permitting training centers, distributors and channel partners to market and sell licenses to Autodesk products, including those bearing the 3DS MAX Mark.” However, 3D Systems fails to see how the production of “[d]ocuments sufficient to show the identity of Autodesk’s Licensees relating to the 3DS MAX Mark” is unduly burdensome. To the extent that these documents contain provisions governing the use or non-use of the 3DS MAX Mark, they are likely to lead to the discovery of admissible evidence and should be produced. Please produce responsive, non-privileged documents forthwith.

RFP No. 10: This Request seeks documents relating to “any use of trademarks or trade names containing the term ‘3DS’” by third parties. Autodesk has declined to produce any documents in response to this Request, instead objecting that the Request is “overbroad and unduly burdensome” and “seeks third-party documents that are...equally available to 3D Systems.” 3D Systems respectfully disagrees. This Request goes to the issue of whether Autodesk has protectable rights in the 3DS MAX Mark, which is centrally at issue in this proceeding, and this information is routinely discoverable in TTAB proceedings. *See, e.g.*, TBMP § 414(9). To the extent that such documents are being withheld due to a claim of privilege, Autodesk is obliged to produce a privilege log. To the extent that Autodesk has responsive, non-privileged documents in its possession, custody or control, these documents must be produced without further delay.

RFP No. 11: Autodesk’s refusal to produce documents responsive to this Request is without basis. This Request goes to the issue of whether Autodesk has protectable rights in the 3DS MAX Mark, which is centrally at issue in this proceeding. Autodesk objects on the grounds that the Request is overbroad and unduly burdensome, vague and ambiguous, and calls for legal conclusions. While 3D Systems does not agree, it is willing to meet and confer with Autodesk to clarify the Request, if required.

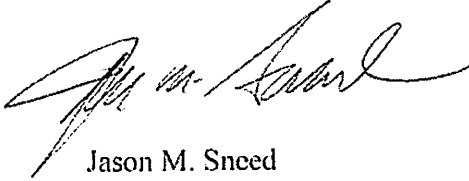
RFP No. 12: The documents responsive to this Request go directly to the issue of whether Autodesk has protectable rights in the 3DS MAX Mark, which is centrally at issue in this proceeding. Autodesk’s refusal to produce documents on the grounds that the Request “does not seek documents relevant to the claims or defenses in this proceeding” is misplaced. Moreover, to the extent that Autodesk intends to rely on assertions of privilege, a privilege log must be produced by Autodesk.

RFP Nos. 14 and 15: These Requests, seeking documents “sufficient to show each use...of the 3DS MAX Mark in conjunction with the promotion or provision of the products and/or services of Autodesk” and “referring or relating to any communication with any advertising agency...” are standard requests, wholly relevant to this proceeding, and 3D Systems can see no basis for Autodesk’s refusal to produce. *See* TBMP § 414(17). Please produce these documents without further delay.

RFP No. 17: Autodesk has refused to produce any documents in response to this Request, which concerns comparisons between the marks at issue in this cancellation proceeding. Such information is clearly relevant, and 3D Systems sees no basis for Autodesk’s refusal to produce, or its objections that the request is “vague and ambiguous” (without any identification of the specific language to which this objection applies) or “overbroad and unduly burdensome.”

3D Systems is very concerned with Autodesk's refusal to disclose information and/or produce documents that are clearly relevant and discoverable. We request a meet and confer to discuss the foregoing deficiencies in Autodesk's discovery responses during the week of March 24, 2014. Please let me know your availability.

Sincerely,

A handwritten signature in black ink, appearing to read "Jason M. Sneed", written in a cursive style.

Jason M. Sneed

cc: Sarah Hsia, Esq.

4843-4699-4201, v. 1

Exhibit 2

March 28, 2014

VIA EMAIL

Jason M. Sneed, Esq.
Sneed PLLC
610 Jetton St., Suite 120-107
Davidson, NC 28036

Re: Autodesk, Inc. v. 3D Systems, Inc.
TTAB Cancellation No. 92056509

Dear Jason:

We write to discuss the responses of Respondent 3D Systems, Inc. ("Respondent") to Autodesk's First Set of Interrogatories to Registrant (the "Interrogatories") and First Set of Requests for Production to Registrant (the "Document Requests," and together with the Interrogatories, the "Discovery Requests"). Respondent's responses to the Discovery Requests are deficient in several respects, including the following:

Responses to the Document Requests

To date, Respondent has not produced any documents to Autodesk. Accordingly, the below issues are not inclusive or reflective of any deficiencies that may be raised in the future with respect to such production.

General Objections

As a general matter, Respondent's General Objections reference the Interrogatories, and appear to have been "cut and pasted" from Respondent's responses to the Interrogatories. For example, Objection No. 8 states that "When answering Petitioner's interrogatories . . . Respondent will respond only with respect to the mark subject to this proceeding" Similarly, Objection No. 9 states "to the extent an interrogatory calls for the provision of information" Accordingly, please review the objections contained in Respondent's response to the Document Requests, and revise them as appropriate to reflect objections specific to the Document Requests.

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Additionally, there are particular General Objections that require clarification or are inapplicable to the Document Requests:

Objection No. 9: Respondent objects to the definition of the term “3DS Product or Service” on the basis that such definition is overly broad, vague and ambiguous, unduly burdensome, and neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. However, Respondent’s objection does not contain any indication or proposal as to an alternative definition for “3DS Product or Service.” Please provide clarification and set forth Respondent’s proposed definition of the term “3DS Product or Service.”

Objection No. 10: Respondent objects to the definition of the term “identify” with respect to a “product” and “service” as overly broad and unduly burdensome, vague and ambiguous. The Document Requests do not contain a definition for the term “identify.” Please strike this objection.

Objection No. 12: Respondent takes issue with Definition Nos. 13, 14, 15 and 16 as “nonsensical and confusing.” Such definitions are standard in discovery requests, and are universally understood as indicating that a verb conjugated in present tense is not limited to present tense but includes past tense as well, a singular form of a word should also be viewed as including plural, and “all” and “each” are to be read as inclusive of one another. Please explain the basis for Respondent’s objection. There is no Definition No. 16 in the Document Requests. Please strike that from Objection 12.

Responses and Objections to Specific Requests

Request No. 1: Respondent’s response indicates that it will not produce documents responsive to this request, which calls for all documents relating to modeling, rendering or animation software or tools offered by Petitioner. However, the identification of goods and services for the registration that is the subject of this proceeding includes goods and services that can potentially be categorized as or are related to “modeling, rendering or animation software or tools.” Accordingly, please confirm that Respondent will produce documents responsive to this request.

Request No. 2: Respondent objects to this request as overly broad and unduly burdensome. Such objection is unfounded, insofar as the request calls only for “documents sufficient to identify” each 3DS Product or Service. Please confirm that in producing responsive documents “showing the scope of the use of the 3DS & Design mark,” Respondent will produce documents sufficient to identify each product or service offered for sale or distribution under the 3DS mark.

Request No. 3: Respondent objects to this request as overly broad and unduly burdensome. Such objection is unfounded, insofar as the request calls only for “documents sufficient to show” use of the mark 3DS in connection with each 3DS Product or Service each year that such product

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or service was offered for sale or distribution. Please confirm that in producing responsive documents “showing the scope of the use of the 3DS & Design mark,” Respondent will produce documents sufficient to show use of the 3DS mark in connection with each product or service offered for sale or distribution under the 3DS mark, for each year that such product or service was offered for sale or distribution.

Request No. 5: Respondent objects to this request on the basis that the request may call for publicly available information and because it objects to the definition of “3DS Product or Service.” Respondent states that it will produce responsive documents showing its first use date per International Class for the 3DS & Design Mark. This is not sufficient to satisfy this request, and Respondent’s stated objections do not relieve Respondent of the obligation to produce documents in its custody or control that are responsive to this request. Please confirm that Respondent will produce all responsive documents related to the earliest date Respondent offered any 3DS Product or Service.

Request No. 9: Respondent’s response indicates that it will not produce documents responsive to this request on the basis that it is overly broad and unduly burdensome, seeks irrelevant documents and things, and calls for proprietary or confidential information. In fact, marketing plans, marketing projections or other marketing documents prepared by or for Respondent relating to the sale, proposed sale, rendering or proposed rendering of any 3DS Product or Service are clearly relevant to this proceeding in that they bear directly on how the subject mark is used in the marketplace. Furthermore, to the extent Respondent has concerns regarding trade secrets or confidential information, such concerns are addressed by the operative Protective Order and provide no basis for refusing to produce these highly relevant documents. Please confirm that Respondent will produce all documents responsive to this request.

Request No. 11: Respondent objects to this request on the basis that it is overly broad and unduly burdensome, calls for publicly available information, and relies on a definition of “3DS Product or Service” to which Respondent objects. Respondent states that it will produce “representative samples” of Respondent’s advertisement, marketing and promotion of goods and services offered and sold under the 3DS & Design mark, including such advertising on its website. To the extent Respondent intends to respond to this request by producing representative samples, please provide a detailed explanation of the methodology employed in selecting such representative samples.

Request No. 12: Respondent’s response indicates that it will not produce documents responsive to this request on the basis that it is overly broad and unduly burdensome, calls for irrelevant documents and things, calls for the production of confidential information, and relies on a definition of “3DS mark” to which Respondent objects. Clearly, a request for documents relating to Respondent’s efforts or plans to promote or expand awareness of the mark 3DS goes directly to Respondent’s intended use of the mark in question and the likelihood of confusion

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with Petitioner's mark. Furthermore, the operative Protective Order addresses any concerns regarding confidentiality. Accordingly, please confirm that Respondent will produce all documents responsive to this request.

Request No. 13: Respondent objects to this request on the basis that it is overly broad and unduly burdensome, calls for confidential information, and utilizes a definition to which Respondent objects. Respondent states that it will produce only documents sufficient to show the overall sales of goods and services, on an annual basis, sold in conjunction with the 3DS & Design Mark. Respondent's objections are groundless in that Petitioner has requested only "documents sufficient to show" and such documents may be protected by the operative Protective Order. Accordingly, to the extent that Respondent possesses documents sufficient to show the annual sales (in dollars and in number of units) of each product offered under the mark 3DS, Respondent has provided no basis for not producing such documents. Please confirm that Respondent will produce such documents.

Request No. 14: Respondent objects to this request on the basis that it is overly broad and unduly burdensome, calls for confidential information, and utilizes a definition to which Respondent objects. Respondent states that it will produce only documents sufficient to show the overall sales of goods and services, on an annual basis, sold in conjunction with the 3DS & Design Mark. Respondent's objections are groundless in that Petitioner has requested only "documents sufficient to show" and such documents may be protected by the operative Protective Order. Accordingly, to the extent that Respondent possesses documents sufficient to show the annual sales (in dollars) of each service rendered under the mark 3DS, Respondent has provided no basis for not producing such documents. Please confirm that Respondent will produce such documents.

Request No. 15: Respondent objects to this request on the basis that it is overly broad and unduly burdensome, calls for confidential information, and utilizes a definition of "3DS Product or Service" to which Respondent objects. Respondent states that it will produce a listing of outlets at which the 3DS & Design mark has been used. Respondent's objections are groundless in that Petitioner has requested only "documents sufficient to show" and such documents may be protected by the operative Protective Order. Accordingly, please confirm that Respondent will produce documents responsive to this request as it was originally articulated.

Request No. 18: Respondent objects to this request on the basis that it calls for confidential information and utilizes a definition to which Respondent objects. Respondent states that it will produce any "license agreements" authorizing any third party to use the mark 3DS & Design. Confidential information is protected by the operative Protective Order, and these objections do not provide a basis for narrowing the request to only "license agreements." The request calls for "all documents, including but not limited to contracts and license agreements, authorizing any third party to use the mark 3DS." Production of only "license agreements" is therefore

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insufficient to satisfy the request, as there are other possible documents that may authorize a third party to use the mark 3DS. Please confirm that Respondent will produce documents responsive to this request as it was originally articulated.

Request No. 22: Respondent objects to this request insofar as it may cover marks considered as possible alternatives to the mark 3DS, on the grounds that it is unduly burdensome, overly broad, and calls for the production of irrelevant material. Respondent states that it will produce documents pertaining to the adoption of the 3DS & Design mark. Consideration of alternative marks is an important part of the selection of a registered mark, and that deliberative process is relevant to several aspects of the current proceeding, including insofar as it goes to Respondent's intent. Please confirm that Respondent will produce documents regarding possible alternative marks to the extent consideration of such alternative marks "pertains to the adoption of the 3DS & Design mark."

Request No. 23: Respondent's response indicates that it will not produce documents responsive to this request on the basis that the request is vague and ambiguous as to the reference to "3DS mark" and on the basis that it calls for documents protected by attorney-client privilege, work product, or other applicable privilege and/or immunity. These objections are unfounded. "3DS mark" is clearly defined in the Definitions, and, to the extent that the request calls for documents protected by privilege or immunity, Respondent must identify such documents in a privilege log. Accordingly, please confirm that Respondent will produce documents responsive to this request.

Request No. 24: Respondent's response indicates that it will not produce documents responsive to this request on the basis that it is overly broad, unduly burdensome, calls for the production of irrelevant materials, and references a definition to which Respondent objects. Documents relating to communications with third parties other than Respondent's legal counsel specifically concerning the mark 3DS are clearly relevant to this proceeding in that they potentially relate to consumer perception and confusion, among other things. Accordingly, please confirm that Respondent will produce documents responsive to this request.

Request No. 25: Respondent's response indicates that it will not produce documents responsive to this request on the basis that it is vague or ambiguous as regards the reference to "the mark 3DS," calls for the disclosure of confidential information, and references a definition to which Respondent objects. The term "the mark 3DS" is clearly defined by Petitioner in its Definitions and confidential information is protected by the operative Protective Order. These objections provide no basis for refusing to produce documents responsive to a request for documents relating to internal communications (other than with Respondent's legal counsel) concerning the right to use the mark 3DS or regarding this trademark dispute. Accordingly, please confirm that Respondent will produce documents responsive to this request.

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Request No. 27: Respondent objects to this request on the basis that it calls for documents protected by privilege, the disclosure of confidential information, the production of publicly available documents, and on the basis that it references a definition to which Respondent objects. Confidential information is adequately protected by the operative Protective Order, and, to the extent that the request calls for documents protected by privilege or immunity, Respondent must identify such documents in a privilege log. Furthermore, the request calls for “all documents relating to trademark applications you have filed for the mark 3DS”; Respondent’s offer to produce “any non-privileged documents consisting of trademark applications pertaining to the mark 3DS & Design filed with the U.S. PTO that are not equally available to Petitioner” is insufficient to satisfy this request, which is not limited to merely the trademark applications themselves, but extends to cover all non-privileged documents relating to such applications. Accordingly, please confirm that Respondent will produce all documents responsive to this request.

Request No. 28: Respondent’s response indicates that it will not produce documents responsive to this request on the basis that it calls for documents protected by privilege/immunity and references a definition to which Respondent objects. Respondent’s objection to the definition of “the mark 3DS” is insufficient grounds to refuse to produce any documents responsive to this request (for Respondent’s investigations regarding the availability, registrability, or use of the mark 3DS), which is highly relevant to this proceeding. To the extent that the request calls for documents protected by privilege or immunity, Respondent must identify such documents in a privilege log. Accordingly, please confirm that Respondent will produce documents responsive to this request.

Request No. 29: Respondent objects to this request on the basis that it calls for documents protected by privilege/immunity and references a definition to which Respondent objects. Respondent states that it will produce search reports pertaining to the mark 3DS & Design, but any related opinions and communications involving Respondent’s attorneys are subject to its privilege/immunity objection. We note that to the extent that the request calls for documents protected by privilege or immunity, Respondent must identify such documents in a privilege log. In addition, please confirm that respondent will produce all trademark searches conducted by Respondent or on Respondent’s behalf in connection with the availability, registrability, or use of the mark 3DS, which may include trademark searches of the mark 3DS & Design, as well as searches pertaining to other marks.

Request No. 30: Respondent’s response indicates that it will not produce documents responsive to this request on the basis that it is vague and ambiguous as to the term “inquiry,” calls for documents protected by privilege/immunity, and references a definition to which Respondent objects. Respondent’s objection to the definition of “the mark 3DS” is insufficient grounds to refuse to produce any documents responsive to this request, which is highly relevant to this proceeding. To the extent that the request calls for documents protected by privilege or

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immunity, Respondent must identify such documents in a privilege log. Accordingly, the only potential remaining objection regards the term “inquiry.” Please explain what is vague or ambiguous about the term “inquiry.”

Request No. 31: Respondent objects to this request on several grounds, including that it is overly broad and unduly burdensome, calls for the production of irrelevant material, is vague and ambiguous, calls for publicly available and confidential information, and references a definition to which Respondent objects. We note that documents relating to consumer recognition of 3DS Products or Services go to the heart of the likelihood of confusion inquiry, and accordingly are highly relevant to this proceeding. Furthermore, confidential information is adequately protected by the operative Protective Order. Respondent states that it will produce a representative sampling of documents evidencing consumer recognition of products and services offered and sold by Respondent in connection with the 3DS & Design Mark. To the extent Respondent intends to respond to this request by producing representative samples, please provide a detailed explanation of the methodology employed in selecting such representative samples.

Request No. 32: Respondent objects to this request on the basis that it is overly broad and unduly burdensome, seeks irrelevant material, is vague and ambiguous, and on the basis that it references a definition to which Respondent objects. This request seeks all documents relating to any confusion as to the origin, endorsement, approval or sponsorship of any 3DS Product or Service. As such, on its face, it goes directly to the heart of this proceeding—the likelihood of confusion regarding the subject mark. Respondent’s offer to produce documents pertaining to “actual confusion relative to Respondent and its 3DS & Design goods and/or services, on the one hand, and Petitioner and its 3DS Max goods and services, on the other hand” is insufficient to satisfy this request, particularly because the request was not limited to “actual confusion” but encompasses documents assessing potential confusion, for example. Accordingly, please confirm that Respondent will produce all documents responsive to this request, at least to the extent such documents pertain to confusion (actual or potential) between Respondent and its 3DS mark and Petitioner.

Request Nos. 38–48: Respondent objects to all of these requests on the grounds that they are unduly broad and overly burdensome, vague and ambiguous, and call for documents protected by privilege/work product. These objections are baseless. Each of these requests clearly specifies the subject of the request (either a denial or affirmative defense contained in Petitioner’s Answer or a document relied on by Petitioner to draft its Answer or its answers to the Interrogatories). To the extent that the requests call for documents protected by privilege or immunity, Respondent must identify such documents in a privilege log. We acknowledge that it is possible that some of the documents responsive to these requests will be produced in response to other requests. Accordingly, please confirm that Respondent will produce all documents responsive to these requests, to the extent any such documents are not otherwise produced in response to other requests.

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Responses to the Interrogatories

Objection No. 9: Respondent objects to the definition of the term “3DS Product or Service” on the basis that such definition is overly broad, vague and ambiguous, unduly burdensome, and neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. However, Respondent’s objection does not contain any indication or proposal as to an alternative definition for “3DS Product or Service.” Please provide clarification and set forth Respondent’s proposed definition of the term “3DS Product or Service.”

Objection No. 12: This objection takes issue with Definition Nos. 13, 14, 15 and 16 as “nonsensical and confusing.” Such definitions are standard in discovery requests, and are universally understood according to their plain meaning. Please indicate specifically what Respondent finds confusing regarding the meaning of these definitions.

Responses and Objections to Specific Interrogatories

Interrogatory No. 1: The answer to Interrogatory No. 1 is insufficient in that it does not provide historical product names. Please supplement this response to provide such information.

Interrogatory No. 2: The answer to Interrogatory No. 2 is implausible and incomplete. The answer to Interrogatory No. 1 sets forth dozens of products, and yet the answer to Interrogatory No. 2 identifies only one person as the most knowledgeable about the scope of Respondent’s products. The Interrogatory requests that Respondent identify the person most knowledgeable about each product or service identified in the response to Interrogatory No. 1. Please supplement this response to provide such information.

Interrogatory No. 3: The answer to Interrogatory No. 3 is incomplete. The Interrogatory requests that Respondent indicate the time period (month/year) that it offered each product or service identified in the answer to Interrogatory No. 1. As mentioned above, Respondent’s answer to Interrogatory No. 1 identifies dozens of products. The answer to Interrogatory No. 2 does not specify this information for each product, but merely addresses product categories. Please supplement this response to provide the requested information.

Interrogatory No. 4: The answer to Interrogatory No. 4 is insufficient. The Interrogatory plainly requests annual sales figures (dollar volume and units) for each of the products identified in the response to Interrogatory No. 1 from the date of first use of the mark 3DS in connection with such product or service to present. The answer to Interrogatory No. 4 merely provides overall sales figures (dollar volume) in total, and not by product. Please amend or supplement this response to provide the requested information.

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Interrogatory No. 5: The answer to Interrogatory No. 5 relies on and is subject to the same deficiencies as the answer to Interrogatory No. 3. Please supplement this response to provide the requested information for each of the identified products (rather than product categories).

Interrogatory No. 6: The answer to Interrogatory No. 6 relies on and is subject to the same deficiencies as the answer to Interrogatory No. 2. Please supplement this response to provide the requested information for each of the identified products.

Interrogatory No. 8: The answer to Interrogatory No. 8 is insufficient in that it fails to identify the requested expenditure information for each product identified in the answer to Interrogatory No. 1. Please supplement this response to provide the requested information for each of the identified products.

Interrogatory No. 9: The answer to Interrogatory No. 9 is insufficient in that it fails to specify the documents in enough detail to allow Autodesk to locate and identify them and Autodesk has not been provided a reasonable opportunity to examine such documents. Please amend or supplement this response to provide a substantive response or the information required pursuant to Fed. R. Civ. P. 33(d).

Interrogatory No. 12: The answer to Interrogatory No. 12 is insufficient in that it fails to specify the documents in enough detail to allow Autodesk to locate and identify them and Autodesk has not been provided a reasonable opportunity to examine such documents. Please amend or supplement this response to provide a substantive response or the information required pursuant to Fed. R. Civ. P. 33(d).

Interrogatory No. 14: The answer to Interrogatory No. 14 is insufficient in that it refers to the answer to Interrogatory No. 13, but fails to address the question asked. Please amend or supplement this response to provide an answer to this Interrogatory.

Interrogatory No. 15: The answer to Interrogatory No. 15 is incomplete because it fails to identify any marks that were considered in the process of selecting the mark 3DS. Please supplement this response to provide such information.

Interrogatory No. 17: Respondent refuses to answer this Interrogatory in its entirety on the basis that it is overly broad and unduly burdensome, seeks irrelevant information, and refers to a definition to which Respondent objects. These objections are unfounded and do not provide a basis for a complete refusal to answer the Interrogatory. Information regarding the quality of the 3DS Products or Services bears on, among other things, questions of damage to Autodesk in the event of consumer confusion. Please provide a substantive response to this Interrogatory.

Interrogatory No. 22: Respondent refuses to answer this Interrogatory in its entirety on the basis that it calls for information that is irrelevant, is vague or ambiguous, and on the basis that it

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March 28, 2014
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refers to a definition to which Respondent objects. These objections are unfounded and do not provide a basis for a complete refusal to answer the Interrogatory. The "mark 3DS" is clearly defined in the Definitions. Searches done by Respondent regarding this mark are relevant to this proceeding in that they establish, among other things, Respondent's intent. Please provide a substantive response to this Interrogatory.

Interrogatory No. 24: The answer to Interrogatory No. 24 is insufficient because it fails to address enforcement efforts other than legal proceedings in the United States. Please supplement this answer to address the Interrogatory in its entirety.

Interrogatory No. 27: The answer to Interrogatory No. 27 is insufficient because it fails to indicate when and how Respondent first became aware of Autodesk and its use of the 3DS mark. Contrary to Respondent's objections, this information is clearly relevant as it goes to Respondent's knowledge of Autodesk and its use of the 3DS mark at the time Respondent filed the application for the registration that is the subject of this proceeding. Please supplement this answer to provide the requested information.

Please note that omission of any particular response to the Discovery Requests in the foregoing does not constitute an acceptance of such response or a waiver of any objections Autodesk may have to such response.

We request a phone conference to discuss the foregoing deficiencies in Respondent's responses to the Discovery Requests. Please let us know your availability generally during the weeks of April 8 and April 14.

Sincerely,



John L. Slafsky

Exhibit 3

June 7, 2014

via U.S. Mail and email

John L. Slafsky, Esq.
Wilson Sonsini Goodrich & Rosati LLP
650 Page Mill Road
Palo Alto, CA 94304-1050
jslafsky@wsgr.com

Re: *Autodesk, Inc. v. 3D Systems, Inc.*, Trademark Trial and Appeal Board
Cancellation No. 92056509

Dear John:

This letter is to summarize the discovery conference we had on May 2, 2014, to discuss the deficiencies in Autodesk's responses to 3D Systems' ("3DS") First Requests for the Production of Documents, Interrogatories, and Requests for Admission.

As an initial matter, we acknowledge receipt of the verification of Autodesk's Interrogatory Responses, and the initial production of documents bates numbered ADSK000001-252, consisting of website materials.

Interrogatory Nos. 1, 6, 12, 17, 22: with respect to the identification of persons most knowledgeable about various topics, we agreed to reserve the right to revisit this issue after depositions, in the event that the witnesses produced by Autodesk are not knowledgeable and/or adequately prepared to speak on the various topics.

Interrogatory No. 2: Autodesk's response, in which it opted to identify documents in accordance with Fed. R. Civ. P. 33(d), did not identify documents with sufficient specificity; you agreed to supplement this response to do so.

Interrogatory No. 5: you agreed to amend Autodesk's response to subpart (i) to identify products and services sold under the 3DS MAX Mark (versus "marks containing the 3DS MAX Mark"), and to supplement this response to answer subpart (v). You agreed to reconsider Autodesk's failure to answer subpart (iii), and investigate whether the information sought in subpart (vi) was available (and produce it if so).

Interrogatory No. 7: you agreed to withdraw Autodesk's objections to this Interrogatory and provide a substantive response.

Interrogatory No. 10: you agreed to supplement Autodesk's response to this Interrogatory to provide a substantive response concerning third parties who are not licensees or customers.

Interrogatory Nos. 13 and 15: you agreed to supplement Autodesk's response to these Interrogatories.

Interrogatory No. 14: you agreed to supplement Autodesk's response concerning its first awareness of the 3DS & Design mark, and to identify a witness knowledgeable about the adoption of the 3DS & Design mark by 3D Systems, if any.

Interrogatory No. 16: you agreed to speak to your client to determine whether Autodesk would be willing to supplement its response to this Interrogatory. Please let us know your client's response.

Interrogatory No. 20: you agreed to supplement Autodesk's response to this Interrogatory and identify a person knowledgeable about the adoption of the 3DS MAX mark, and to ascertain whether documents concerning the creation, selection and adoption of the 3DS MAX mark exist (and to produce them if so).

Interrogatory No. 25: you agreed to "take a fresh look" at Autodesk's refusal to answer this Interrogatory. Please let us know your position.

Request for Admission No. 1: in an attempt to resolve Autodesk's objection that this RFA was "vague and unintelligible," we explained that by "functional purpose," we meant whether the term "3DS" may be used as a filename extension to identify files that are compatible with certain programs or applications. Please supplement your response to this RFA accordingly.

Request for Admission No. 2: in an attempt to resolve Autodesk's objection that this RFA was "vague and unintelligible," we explained that the phrase "available freely for use by anyone as a filename extension," referred to the availability of use of the "3DS" term as a filename extension by third parties to create software files, or to create programs that can read software files using this filename extension. Please supplement your response to this RFA accordingly.

Requests for Production Nos. 7, 10, 17: you agreed to produce non-privileged documents responsive to these requests, if any exist.

Request for Production No. 9: you agreed to produce representative samples of documents sufficient to show the categories of licensees.

Request for Production Nos. 11 and 12: you indicated that Autodesk was objecting to these requests on the grounds of relevance (even though you did not assert this objection in Autodesk's response to Request for Production No. 11) and would not produce documents in response to these requests.

Request for Production No. 14: you agreed to produce documents in response to this request.

Request for Production No. 15: you agreed to produce documents sufficient to identify any advertising agencies, and substantive communications therewith regarding the promotion, advertising and marketing of the 3DS MAX brand.

Please provide us with your amended and supplemented responses as soon as possible, and let us know when you expect to produce additional documents.

Sincerely,

A handwritten signature in black ink, appearing to read "J. M. Sneed", with a long horizontal flourish extending to the right.

Jason M. Sneed

cc: Sarah C. Hsia, Esq. (via email)

Exhibit 4

August 5, 2014

via email

John L. Slafsky, Esq.
Wilson Sonsini Goodrich & Rosati LLP
650 Page Mill Road
Palo Alto, CA 94304-1050
jslafsky@wsgr.com

Re: *Autodesk, Inc. v. 3D Systems, Inc.*, Trademark Trial and Appeal Board
Cancellation No. 92056509

Dear John:

This letter responds to Ms. Brannen's letter of June 18, 2014, concerning the deficiencies in Autodesk's responses to 3D Systems' discovery requests. We request a meet and confer prior to August 13, 2014 to discuss the remaining deficiencies and to satisfy our obligation under Fed. R. Civ. P. 37(a)(1) and 37 C.F.R. § 2.120(e)(1) to make a good faith effort to resolve these issues prior to filing a Motion to Compel.

As an initial matter, we still have not received supplementation of Autodesk's discovery responses, even though you agreed to supplement Autodesk's responses during our discovery conference in early May, three months ago. As you are undoubtedly aware, discovery closes in a few short weeks, and our discovery efforts are severely prejudiced by Autodesk's failure to comply with its discovery obligations. Please supplement Autodesk's discovery responses without further delay.

Interrogatory No. 5: our notes clearly indicate that you agreed to amend Autodesk's response to subpart (a) even though you thought it was unnecessary, and we are thus surprised that you are now refusing to do so. With respect to subpart (b)(v), you agreed to supplement and have not yet done so. With respect to subpart (b)(vi), you agreed to investigate and produce information to the extent it was available; we have still not heard from you whether you intend to produce any further information or not. With respect to subpart (b)(iii), you have not indicated definitively whether you will agree to supplement this response; however, we note that the information sought by this subpart (classes or types of customers) is directly relevant to the issues in this Cancellation proceeding, and we thus require a full and definite answer. Please advise if Autodesk intends to supplement its response to this subpart.

Interrogatory No. 20: our notes clearly indicate that you agreed to supplement Autodesk's response to this Interrogatory and identify a person knowledgeable about the adoption of the 3DS MAX mark, and to ascertain whether documents concerning the creation, selection and adoption of the 3DS MAX mark exist (and to produce them if so). We still have

not received any indication from you, three months later, as to whether such documents exist, and no supplementation has been made.

Interrogatories No. 2, 10, 13, 15, 14: you agreed to supplement Autodesk's responses to these Interrogatories, but we have still not received any supplementation.

Interrogatories No. 16, 25: you agreed to consult with your client as to whether it was willing to supplement, but you have still not advised us what their position is with respect to these Interrogatories, nor has any supplementation been made. With particular regard to Interrogatory No. 25, which requires you to explain the basis for your refusal to admit any Request for Admission, please be advised that we are prepared move to compel an answer to this Interrogatory if you client declines to provide an answer.

Requests for Admission No. 1 and 2: we believe that evidence concerning the use of "3DS" as a file extension is directly relevant to the strength of Autodesk's 3DS MAX mark, and we are puzzled by your refusal to answer these RFAs. It is interesting that you apparently concur with our position with respect to Autodesk's Interrogatory responses, as you have agreed to identify a witness to testify about the adoption of ".3ds" as a file extension (Interrogatory No. 22), and responded to an Interrogatory asking Autodesk to "[d]escribe the nature of the ".3ds" filename extension" (Interrogatory No. 23), but refuse to answer these Requests for Admission, despite 3D Systems' clarification in response to your "vague and unintelligible" objections. We further refer you to Judge Alsup's Order in the *Autodesk v. Dassault Systèmes Solidworks Corp.* case pertaining to the issue of functionality, of which you are surely aware. We believe that your objections and refusal to answer these RFAs are baseless, and we again ask that you withdraw your objections and answer these RFAs, failing which we will move to compel.

Finally, we note that we have yet to receive a privilege log from Autodesk. Please send this without further delay.

Please provide us with the earliest possible dates and times you are available for a telephonic meet and confer to discuss the foregoing.

Sincerely,

A handwritten signature in black ink, appearing to read "Sarah C. Hsia".

Sarah C. Hsia, Esq.

cc: Jason M. Sneed, Esq. (via email)
Stephanie Brannen, Esq. (via email)

Exhibit 5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Autodesk, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92056509
)	
3D Systems, Inc.,)	
)	
Respondent.)	

**PETITIONER AUTODESK'S AMENDED RESPONSES TO
CERTAIN REQUESTS FOR PRODUCTION FROM RESPONDENT 3D SYSTEMS**

Pursuant to the Federal Rules of Civil Procedure 26 and 34 as well as the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Petitioner Autodesk, Inc. ("Autodesk"), by and through its undersigned counsel, hereby provides amended responses to certain requests from the First Set of Requests for the Production of Documents and Things ("Requests") by Respondent 3D Systems, Inc. ("3D Systems") as follows:

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they are inconsistent with or seek to impose obligations greater than those imposed by the Federal Rules of Civil Procedure and the TBMP.

GENERAL OBJECTION NO. 2:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they seek the production of documents or information that: (1) are protected by the attorney-client privilege; (2) constitute work product of Autodesk's attorneys; and/or (3) are otherwise privileged. Any inadvertent disclosure of such information shall not be deemed a waiver of the attorney-client privilege, the work product doctrine, or any other applicable privilege or immunity recognized by statute or case law.

GENERAL OBJECTION NO. 3:

Autodesk objects to the Requests, and to each and every individual request contained therein, as unduly burdensome and oppressive to the extent that they purport to require Autodesk to search Autodesk facilities and inquire of Autodesk employees other than those facilities and employees that would reasonably be expected to have responsive information. Autodesk's responses are based upon: (1) a reasonable search, given the time allotted to Autodesk to respond to these Requests, of facilities and files that could reasonably be expected to contain responsive information or documents; and (2) inquiries of Autodesk employees and/or representatives who could reasonably be expected to possess responsive information. The subject matter of these Requests is under continuing investigation. Accordingly, these responses are limited to and are applicable only to documents and other information which Autodesk's counsel has been able to ascertain and locate as of the date hereof. Autodesk expressly reserves the right to use, rely upon, and offer into evidence any and all documents and other information responsive to these requests, whether or not presently identified or produced, if the documents or other information have not been obtained by counsel and deemed responsive by counsel as of the date of this response, or if the responsiveness of the documents or other information has been overlooked in good faith, or if an objection is interposed to producing a document or other information.

GENERAL OBJECTION NO. 4:

To the extent that the Requests seek confidential or proprietary information pertaining to Autodesk's business, trade secrets and/or economic relationships, Autodesk will only produce such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board.

GENERAL OBJECTION NO. 5:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they call for the production of documents or things which are confidential or proprietary to, or contain the trade secrets of, a third party. Each such request is overly broad,

unduly burdensome, oppressive, and seeks to impose obligations beyond those permitted by the TBMP and the Federal Rules of Civil Procedure. Autodesk will only produce such material subject to the terms of the Protective Order and upon receipt of permission from the third party, if necessary.

GENERAL OBJECTION NO. 6:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent that they call for the production of “all documents” where compliance with such request would be unduly burdensome. In the event a request seeking “all documents” is unduly burdensome, Autodesk will produce documents sufficient to respond to 3D Systems’ request pursuant to TBMP § 414.

GENERAL OBJECTION NO. 7:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they seek documents related to experts. Autodesk will meet and confer with 3D Systems to determine a time when the parties can simultaneously exchange expert-related documents.

GENERAL OBJECTION NO. 8:

Autodesk objects to the Requests, and to each and every individual request contained therein, as overbroad, unduly burdensome and not reasonably calculated to lead to the production of relevant evidence to the extent they seek documents related to proceedings or the use of marks outside of the United States. Actions taken outside of the United States, and documents relating thereto, are not relevant to this proceeding.

GENERAL OBJECTION NO. 9:

Autodesk objects to the “Definitions” contained in the Requests insofar as they contain instructions rather than definitions for terms and are thus ambiguous.

RESPONSES

REQUEST FOR PRODUCTION NO. 7:

All documents and things referring or relating to the application for, issuance, use or licensing or enforcement of, or challenges to, any trademark registrations containing the term “3DS.”

AMENDED RESPONSE TO REQUEST FOR PRODUCTION NO. 7:

Autodesk objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Autodesk objects to this request as overbroad and unduly burdensome. Autodesk objects to this request as vague and ambiguous. Autodesk objects to this request to the extent it seeks third-party documents that are not in Autodesk’s possession, custody or control or are equally available to 3D Systems.

Following clarification from 3D Systems that this request is limited to documents relating to third-party trademark registrations for marks containing the term “3DS,” subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 9:

Documents sufficient to show the identity of Autodesk’s Licensees relating to the 3DS MAX Mark.

AMENDED RESPONSE TO REQUEST FOR PRODUCTION NO. 9:

Autodesk objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Autodesk objects to this request to the extent that “Licensees relating to the 3DS MAX Mark” is vague, ambiguous and unintelligible. Autodesk further objects to this request on the grounds that it is overly broad and unduly burdensome. Autodesk has entered into thousands of agreements permitting training centers, distributors and channel partners to market and sell licenses to Autodesk products, including those bearing the 3DS MAX Mark.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce a representative sample of documents sufficient to identify categories of typical agreements responsive to this request.

REQUEST FOR PRODUCTION NO. 10:

All documents and things referring or relating to any use of trademarks or trade names containing the term "3DS" by any person or entity other than Petitioner and Respondent.

AMENDED RESPONSE TO REQUEST FOR PRODUCTION NO. 10:

Autodesk objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Autodesk objects to this request as overbroad and unduly burdensome. Autodesk objects to this request to the extent it seeks third-party documents that are not in Autodesk's possession, custody or control or are equally available to 3D Systems.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 11:

All documents and things referring or relating to any functional use of the term "3DS" by any person or entity other than Petitioner and Respondent.

AMENDED RESPONSE TO REQUEST FOR PRODUCTION NO. 11:

Autodesk objects to this request as overbroad and unduly burdensome. Autodesk objects to this request as vague and ambiguous. Autodesk objects to this request to the extent it calls for legal conclusions. Autodesk further objects to this request on the grounds that it does not seek documents relevant to the claims or defenses in this proceeding.

REQUEST FOR PRODUCTION NO. 14:

Documents sufficient to show each use (or proposed use) of the 3DS MAX Mark in conjunction with the promotion or provision of the products and/or services of Autodesk and/or its Licensees, including, without limitation, promotional literature, printed or digital (including

Internet) advertisements, business cards, signage, radio and television commercials, and website content.

AMENDED RESPONSE TO REQUEST FOR PRODUCTION NO. 14:

Autodesk objects to this request as overbroad and unduly burdensome.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 15:

All documents and things referring or relating to any communication with any advertising agency, marketing or market research firm, public relations firm, or other consultant or contractor relating to use of the 3DS MAX Mark or any variant thereof.

AMENDED RESPONSE TO REQUEST FOR PRODUCTION NO. 15:

Autodesk objects to this request as overbroad and unduly burdensome.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce substantive communications with any advertising agency regarding the promotion, advertising and marketing of the 3DS MAX brand that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 17:

All documents and things comparing use of the 3DS MAX Mark by Autodesk or its Licensees, to 3D Systems' use of the 3DS & Design Mark.

AMENDED RESPONSE TO REQUEST FOR PRODUCTION NO. 17:

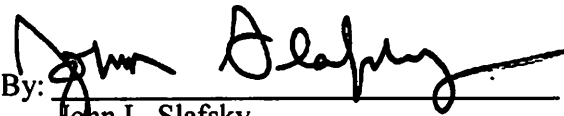
Autodesk objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Autodesk objects to this request as vague and ambiguous. Autodesk also objects to this request as overbroad and unduly burdensome.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

Dated: August 7, 2014

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: 
John L. Slafsky

Attorneys for Petitioner
AUTODESK, INC.

CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California, 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I caused to be personally served **PETITIONER AUTODESK'S AMENDED RESPONSES TO CERTAIN REQUESTS FOR PRODUCTION FROM RESPONDENT 3D SYSTEMS** on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I placed the envelope(s) for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on August 7, 2014.


Elvira Minjarez

Exhibit 6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Autodesk, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92056509
)	
3D Systems, Inc.,)	
)	
Respondent.)	

**PETITIONER AUTODESK, INC.'S RESPONSES TO
RESPONDENT 3D SYSTEMS, INC.'S SECPMD SET OF REQUESTS
FOR THE PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to the Federal Rules of Civil Procedure 26 and 34 as well as the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Petitioner Autodesk, Inc. ("Autodesk"), by and through its undersigned counsel, hereby responds to the Second Set of Requests for the Production of Documents and Things ("Requests") by Respondent 3D Systems, Inc. ("3D Systems") as follows:

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they are inconsistent with or seek to impose obligations greater than those imposed by the Federal Rules of Civil Procedure and the TBMP.

GENERAL OBJECTION NO. 2:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they seek the production of documents or information that: (1) are protected by the attorney-client privilege; (2) constitute work product of Autodesk's attorneys; and/or (3) are otherwise privileged. Any inadvertent disclosure of such information shall not be deemed a waiver of the attorney-client privilege, the work product doctrine, or any other

applicable privilege or immunity recognized by statute or case law.

GENERAL OBJECTION NO. 3:

Autodesk objects to the Requests, and to each and every individual request contained therein, as unduly burdensome and oppressive to the extent that they purport to require Autodesk to search Autodesk facilities and inquire of Autodesk employees other than those facilities and employees that would reasonably be expected to have responsive information. Autodesk's responses are based upon: (1) a reasonable search, given the time allotted to Autodesk to respond to these Requests, of facilities and files that could reasonably be expected to contain responsive information or documents; and (2) inquiries of Autodesk employees and/or representatives who could reasonably be expected to possess responsive information. The subject matter of these Requests is under continuing investigation. Accordingly, these responses are limited to and are applicable only to documents and other information which Autodesk's counsel has been able to ascertain and locate as of the date hereof. Autodesk expressly reserves the right to use, rely upon, and offer into evidence any and all documents and other information responsive to these requests, whether or not presently identified or produced, if the documents or other information have not been obtained by counsel and deemed responsive by counsel as of the date of this response, or if the responsiveness of the documents or other information has been overlooked in good faith, or if an objection is interposed to producing a document or other information.

GENERAL OBJECTION NO. 4:

To the extent that the Requests seek confidential or proprietary information pertaining to Autodesk's business, trade secrets and/or economic relationships, Autodesk will only produce such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board.

GENERAL OBJECTION NO. 5:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they call for the production of documents or things which are confidential or proprietary to, or contain the trade secrets of, a third party. Each such request is overly broad,

unduly burdensome, oppressive, and seeks to impose obligations beyond those permitted by the TBMP and the Federal Rules of Civil Procedure. Autodesk will only produce such material subject to the terms of the Protective Order and upon receipt of permission from the third party, if necessary.

GENERAL OBJECTION NO. 6:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent that they call for the production of “all documents” where compliance with such request would be unduly burdensome. In the event a request seeking “all documents” is unduly burdensome, Autodesk will produce documents sufficient to respond to 3D Systems’ request pursuant to TBMP § 414.

GENERAL OBJECTION NO. 7:

Autodesk objects to the Requests, and to each and every individual request contained therein, to the extent they seek documents related to experts. Autodesk will meet and confer with 3D Systems to determine a time when the parties can simultaneously exchange expert-related documents.

GENERAL OBJECTION NO. 8:

Autodesk objects to the Requests, and to each and every individual request contained therein, as overbroad, unduly burdensome and not reasonably calculated to lead to the production of relevant evidence to the extent they seek documents related to proceedings or the use of marks outside of the United States. Actions taken outside of the United States, and documents relating thereto, are not relevant to this proceeding.

GENERAL OBJECTION NO. 9:

Autodesk objects to the “Definitions” contained in the Requests insofar as they contain instructions rather than definitions for terms and are thus ambiguous.

REQUESTS FOR PRODUCTION

REQUEST FOR PRODUCTION NO. 48:

All documents and things referring or relating to Autodesk's knowledge or awareness of any designation, trademark or moniker comprised of or containing the term "3DS" used by any third party in connection with software.

RESPONSE TO REQUEST FOR PRODUCTION NO. 48:

Autodesk objects to this request to the extent that it purports to impose duties on Autodesk that are greater than those imposed by the Federal Rules of Civil Procedure and/or the TBMP. Autodesk further objects to this request to the extent it is overly broad, unduly burdensome, and seeks information that is not relevant to the claim or defense of any party, and therefore not reasonably calculated to lead to the discovery of admissible evidence. Autodesk objects to this request as duplicative, in whole or in part, of previous Requests for Production, to which Autodesk has produced or will be producing responsive documents, including Request for Production No. 10.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that to the extent it has already agreed to produce documents responsive to this request (as encompassed by previous Requests for Production, including Request for Production No. 10), Autodesk reiterates that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 49:

All documents and things referring or relating to Autodesk's knowledge or awareness of any third-party software product that enables its users to save files with a file extension containing the term "3DS."

RESPONSE TO REQUEST FOR PRODUCTION NO. 49:

Autodesk objects to this request to the extent that it purports to impose duties on Autodesk that are greater than those imposed by the Federal Rules of Civil Procedure and/or the TBMP. Autodesk further objects to this request to the extent it is overly broad, unduly

burdensome, and seeks information that is not relevant to the claim or defense of any party, and therefore not reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 50:

All documents and things referring or relating to the domain name <3ds.com>.

RESPONSE TO REQUEST FOR PRODUCTION NO. 50:

Autodesk objects to this request to the extent that it purports to impose duties on Autodesk that are greater than those imposed by the Federal Rules of Civil Procedure and/or the TBMP. Autodesk objects to this request to the extent it seeks documents not in the possession, custody, or control of Autodesk. Autodesk further objects to this request to the extent it is overly broad, unduly burdensome, and seeks information that is not relevant to the claim or defense of any party, and therefore not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 51:

Any and all documents and things dated prior to January 22, 2001 concerning, in whole or in part, the advertisement, promotion, offering for sale, or marketing of software products or services by anyone, in connection with which any mark containing the term “3DS” was used.

RESPONSE TO REQUEST FOR PRODUCTION NO. 51:

Autodesk objects to this request to the extent that it purports to impose duties on Autodesk that are greater than those imposed by the Federal Rules of Civil Procedure and/or the TBMP. Autodesk objects to this request to the extent it seeks documents not in the possession, custody, or control of Autodesk. Autodesk further objects to this request to the extent it is overly broad, unduly burdensome, and seeks information that is not relevant to the claim or defense of any party, and therefore not reasonably calculated to lead to the discovery of admissible evidence. Autodesk objects to this request as duplicative, in whole or in part, of several of

Respondent's previous Requests for Production, including but not limited to Requests for Production Nos. 30-33.

Subject to and without waiving its General Objections and its specific objections above, Autodesk responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 52:

All documents and things referred to or relied on in responding to Respondent 3D Systems Inc.'s Second Set of Interrogatories to Petitioner and/or Second Set of Requests for Admission to Petitioner.

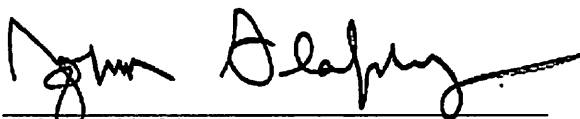
RESPONSE TO REQUEST FOR PRODUCTION NO. 52:

Autodesk objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving its General Objections, Autodesk responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

Dated: September 10, 2014

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: 
John L. Slafsky

Attorneys for Petitioner
AUTODESK, INC.

CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California, 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I caused to be personally served **PETITIONER AUTODESK, INC.'S RESPONSES TO RESPONDENT 3D SYSTEMS, INC.'S SECOND SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS** on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I placed the envelope(s) for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on September 10, 2014.


Elvira Minjarez

Exhibit 7

UNITED STATES DISTRICT COURT FOR THE
EASTERN DISTRICT OF VIRGINIA
Alexandria Division

AUTODESK, INC.,)	
)	
Plaintiff,)	
v.)	Civil Action No. 1:13-cv-1464 (AJT/JFA)
)	
MICHELLE K. LEE,)	
)	
Defendant.)	
_____)	

MEMORANDUM OPINION

Plaintiff Autodesk, Inc. (“Autodesk”) appeals the decision of the United States Patent and Trademark Office (USPTO) to deny trademark registration to the mark “DWG.” The case is before the Court on cross-motions for summary judgment. For the reasons stated below, the Defendant’s Motion for Summary Judgment is GRANTED, and the Plaintiff’s Motion for Summary Judgment is DENIED.

I. Background

Plaintiff Autodesk is a design software company that since the 1980s has developed computer-aided design (CAD) software that is used by architects and engineers to design and build two- and three-dimensional virtual models of buildings, products and other physical objects. Autodesk’s most successful and best known product is AutoCAD, and according to Autodesk, its AutoCAD sales have totaled over \$11 billion. “DWG” is Autodesk’s name for the digital file format and technology underlying AutoCAD. DWG has become one of the most

commonly used design data formats; and companies other than Autodesk have developed software using that format. *See, e.g.*, A119, A123, PTO 1095, PTO 1025.¹

On April 3, 2006, Autodesk filed an application to register five marks covering computer software: DWG, DWG & DESIGN (a design plus word mark), DWG TRUEVIEW, DWG TRUECONVERT, and DWG EXTREME (collectively, “the DWG Application”).

On June 9, 2011, the United States Patent and Trademark Office (USPTO) issued Final Office Actions against Autodesk denying the DWG Application on the ground that “DWG” was descriptive and Autodesk failed to establish acquired distinctiveness. Briefly summarized, the USPTO reasoned that “dwg” is the abbreviation for “drawing” and “.dwg” is the file extension on a type of file Autodesk created but which has come to be used descriptively by others in the industry, and for which Autodesk has disavowed any proprietary rights. For these reasons, the USPTO refused to register the DWG and the other marks unless Autodesk disclaimed exclusive rights to “DWG.”

On December 8, 2011, Autodesk filed a notice of appeal to the Trademark Trial and Appeal Board (TTAB), which issued an order affirming the USPTO decision on September 30, 2013. On November 27, 2013, Autodesk filed this action to challenge and reverse the TTAB’s

¹ For example, Autodesk’s website describes its DWG technology as “the original and accurate way to store and share design data when working with AutoCAD® software. With billions of DWG files circulating throughout every design industry, it’s the world’s most commonly used design data format.” A119. Similarly, Autodesk’s “DWG TrueView” product is described as offering the ability to “view .dwg files with Autodesk® DWG TrueView™ software . . . By installing the free* Autodesk® Design Review software, you can then open .dwg files as well as view, print and track changes to Autodesk 2D and 3D design files without the original design software.” PTO 1025.

September 30, 2013 decision pursuant to Section 21(b) of the U.S. Trademark Act of 1946 (“the Lanham Act”), 15 U.S.C. § 1071(b).²

The parties have filed cross motions for summary judgment. They have also stipulated that the Court should resolve any material factual disputes without any further proceeding based on the summary judgment record before the Court, effectively stipulating to a trial upon stipulated facts.³ *See* Doc. No. 36. On September 18, 2014, the Court held a hearing on these motions, following which the Court took the motions under advisement.

II. Standard of Review

Autodesk has introduced evidence in addition to that presented in USPTO proceedings. The Court therefore reviews the record *de novo* and acts as the finder of fact based on the entire record presently before the Court. *See Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 156 (4th Cir. 2014) (“where new evidence is presented to the district court on a disputed fact question, a *de novo* finding will be necessary to take such evidence into account together with the evidence before the board”) (internal citation omitted).

Section 2 of the Lanham Act provides that a mark that is descriptive of the goods in connection with which it is used cannot be registered unless the registrant proves that the mark

² 5 U.S.C. § 1071(b) permits a party in a trademark suit to contest the TTAB's determination in a new civil action in district court rather than through an appeal to the Federal Circuit. *See Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014).

³ Autodesk asks the Court to restrict the factual record on which the Court decides the case to those facts in Autodesk's July 2, 2014 statement of undisputed facts [Doc. No. 43]. In support of this request, Autodesk contends that the USPTO violated Local Civil Rule 56 and the Court's Order dated February 24, 2014 [Doc. No. 33], by not including within its brief a separately captioned section listing, in numbered-paragraph form, each material fact that the movant contends is undisputed with appropriate citations to the record. After reviewing this issue, the Court will consider the entire factual record, as presented and discussed by both parties.

has acquired distinctiveness, also called secondary meaning. 15 U.S.C. § 1052(f); *see Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000). “DWG” is, at best, a descriptive mark.⁴ To establish secondary meaning, Autodesk must therefore show that “in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n.11 (1982). However, in order to establish its entitlement to trademark registration, Autodesk must make only a “prima facie showing” of distinctiveness, rather than a conclusive showing. *See Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1576 (Fed. Cir. 1988).

III. Analysis

The Fourth Circuit has articulated certain non-exhaustive factors relevant to determining secondary meaning *vel non*: “(1) advertising expenditures; (2) consumer studies linking the mark to a source; (3) sales success; (4) unsolicited media coverage of the product; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the mark’s use.” *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990). “In assessing the existence of secondary meaning, no single factor is determinative ... and every element need not be proved. Each case,

⁴ Marks fall into the following four categories, in ascending strength or distinctiveness: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. *See America Online v. AT&T Corp.*, 243 F.3d 812, 816 (4th Cir. 2001). “Generic terms are the common name of a product or service itself, and can *never* be trademarks.” *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996); *see also CES Pub. Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975). “[A] mark which is merely descriptive is considered to be weak and cannot be accorded trade mark protection without proof of secondary meaning, whereas a mark which is either suggestive or arbitrary is strong and presumptively valid.” *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984) (quoting *Del Laboratories, Inc. v. Alleghany Pharmacal Corp.*, 516 F.Supp. 777, 780 (S.D.N.Y.1981). Courts have acknowledged that the “lines of demarcation between the four classes listed above are not always bright.” *Reese Pub. Co. v. Hampton Int’l Commc’ns, Inc.*, 620 F.2d 7, 10 (2d Cir. 1980).

therefore, must be resolved by reference to the relevant factual calculus.” *Dick's Sporting Goods, Inc. v. Dick's Clothing & Sporting Goods, Inc.*, 188 F.3d 501 at *4 (4th Cir. 1999). Upon review of the facts pertaining to those considerations, the Court finds that Autodesk has not adequately demonstrated consumer perception that DWG, standing alone, signifies an Autodesk product, as opposed to the DWG digital formatting of products, even though the consumer may think many such products are issued by Autodesk.

(1) Advertising Expenditures

Autodesk points to its significant expenditures, approximately \$40-\$60 million per year between 2007 and 2013, on advertising and marketing products that incorporate DWG technology (i.e., software that works on and is compatible with dwg formatted files) and display the DWG mark on their packaging. These expenditures, however, have limited, if any, significance with respect to establishing secondary meaning since there is no evidence that these expenditures involve the advertising or marketing of “DWG” as a stand- alone brand name, as opposed to its designation of product functionality within the context of actual Autodesk brand name products, some of which may include the DWG mark or icon. *See* Doc. No. 50 at 15-16, n.19; *see also Carefirst of Maryland, Inc. v. Fire Care, P.C.*, 434 F.3d 263, 270-71 (4th Cir. 2006) (finding that \$50 million in advertising expenditures did not establish a registered mark’s commercial strength because the mark never appears standing alone); *In re Chem. Dynamics, Inc.*, 839 F.2d 1569 (Fed. Cir. 1988) (concluding that generalized sales and advertising figures do not establish secondary meaning where the alleged mark is not promoted by itself but instead as part of a larger mark or with other designs or marks); and *In re Bongrain Intern. (American) Corp.*, 894 F.2d, 1316, 1318 (Fed. Cir. 1990) (“Growth in sales . . . may indicate the popularity

of the product itself rather than recognition of the mark [] as indicative of origin. . .”). In fact, it appears to the Court that Autodesk uses and promotes the DWG label typically in a descriptive sense, to indicate software that works on, or is compatible with, dwg formatted files, as reflected, in part, by the placement of a “DWG” file icon on the back cover of packaging, and at times next to the logo of another company. *See* Doc. No. 50 at 16 & n.19-22; *see also* TTAB Opinion at 24 (“An examination of the sample packaging in the record reveals that the icon is depicted in the back of the packaging, and the primary marks for the product are AUTOCAD and AUTODESK.”).

(2) Consumer studies linking the mark to a source

Properly constructed consumer surveys can provide some of the most persuasive evidence of secondary meaning. *See U.S. Search, LLC v. U.S. Search.com Inc.*, 300 F.3d 517, 526 n.13 (4th Cir. 2002) (“Survey evidence is generally thought to be the most direct and persuasive way of establishing secondary meaning.”) Autodesk relies heavily on two surveys that it conducted, which it contends establish that DWG has acquired the required distinctiveness for trademark protection, one presented in the USPTO proceedings and one prepared nine years after the first, following the TTAB decision, and now part of the record before the Court. The first survey was performed by Dr. Deborah Jay in in 2005-2006 (hereafter “Jay Survey”). The second survey was performed by Dr. Gerald Ford in 2014 (hereafter “Ford Survey”). The key question relied on by Autodesk in the Jay Survey asked participants whether they “associate the name or term ‘DWG’ with design software from any particular company or companies.” Of the

308 participants, 42% associated “DWG” exclusively with Autodesk or its product, AutoCAD.⁵

The key question in the Ford survey asked participants whether they associated the letters “DWG” with packaging, advertising, or marketing materials for design software from any particular company or companies. 44% reported an association with Autodesk.

To support its claims of secondary meaning, the surveys must demonstrate that consumers perceive DWG as an indicator that Autodesk is the source of a product labeled simply “DWG,” not merely that the product has certain functionality associated with DWG or that a product that has DWG functionality has some association with Autodesk. *See Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (party seeking to register trademark “must show that the primary significance of the term in the minds of the consuming public is not the product but the producer”). Here, both surveys suffer from the same fundamental flaw- neither adequately establishes precisely what a participant understood by the term “DWG;” and one would need to speculate whether a participant, in “associating” “DWG” with Autodesk, was identifying a perception that a product labeled “DWG” means that it is an Autodesk proprietary product or that the product has functionality or characteristics of software with the .dwg formatting created and popularized by Autodesk. *See Inwood Laboratories, supra*, 456 U.S. at 851 n.11 (“To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”); *Wal-Mart Stores, supra*, 529 U.S. at 211 (“[a mark] has developed secondary meaning . . . when, in the minds of the public, the primary significance of a

⁵ In its proceedings, the USPTO and TTAB found the Jay survey unpersuasive because it did not distinguish between the use of DWG as a trademark and its use as a file extension name. *See* TTAB Opinion at 18.

[mark] is to identify the source of the product rather than the product itself.”) (citing *Inwood*); *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1018 (9th Cir. 1979) (“While a “merely descriptive” term is not generally entitled to protection (15 U.S.C. s 1052(e)), if the applicant for registration can show that a “secondary meaning” has attached to the mark, so that the consuming public connects the mark with the producer rather than the product, the mark can be protected.”); *see also* MCCARTHY § 15:7 & n.6. In short, the survey results may demonstrate nothing more than that Autodesk is most strongly associated with products using the .dwg file extension (as, indeed, a number of Ford survey respondents affirmatively offered in their answers). *See* Doc. No. 43-3, Appendix A. In fact, the ambiguous nature of the survey results are underscored by Autodesk’s own consistent use of DWG descriptively, that is, its use of DWG to refer to the type of digital file that its software creates and the compatibility of software with DWG file formatting. Because neither the Jay nor the Ford surveys adequately reveals the nature of the association a consumer perceives between DWG and Autodesk, the Court cannot conclude that responding consumers necessarily viewed DWG as an Autodesk branded product. *See* TTAB Opinion at 17-20 (analysis of Jay Survey).

(3) Sales success

In further support of its claim of secondary meaning, Autodesk points to its substantial revenues from products bearing the DWG mark. *See* Gennarelli Decl. at ¶ 4-5 (stating that in each of the years from 2011 until 2014, Autodesk’s net revenue for the “DWG Family” of products exceeded \$400 million annually, and that to date, “Autodesk has earned over \$2.6 billion in revenues from the sale of products in the DWG Family in the U.S.”). For the same reasons previously explained with respect to advertising expenditures, the sheer volume of

Autodesk's sales revenue does not establish secondary meaning since the sold products are not branded with an unadorned DWG label, but rather with branding that incorporates DWG as part of a larger mark or with other designs or marks. *See* Doc. No. 50 at 15-16, n.18; *In re Chem. Dynamics, supra*, 839 F.2d at 1571.

(4) Unsolicited media coverage of the product

As evidence of unsolicited media coverage of DWG, Autodesk points to the number of online searches using "dwg" that resulted in visits to the <autodesk.com> or other Autodesk websites. *See* Buxton Decl. at ¶ 13-14 (stating, based on his analysis, that from January 1, 2013 to April 22, 2014, more than 46,000 visits to Autodesk websites resulted from on-line searches using "dwg" and that from November 1, 2011 to March 31, 2014, "dwg" was included in 16 of the top 200 keywords that users entered into search engine queries to arrive at <autodesk.com>.) It is unclear how or why this data constitutes unsolicited media coverage. *Cf., Venetian Casino Resort, LCC v. Venetiangold.Com*, 380 F.Supp.2d 737, 743 (E.D.Va. 2005) (finding secondary meaning where, among other things, Plaintiff "enjoyed substantial unsolicited media coverage ... including features on all major broadcast and cable networks."). In any event, this internet usage would appear to suggest nothing more than that consumers associate "dwg" with .dwg compatible software products sold by Autodesk.

(5) Attempts to plagiarize the mark

Autodesk also points to seven proceedings it has undertaken to enforce its DWG trademarks, five before the TTAB against the marks DWG CRUISER, RASTERDWG, DWGEDITOR, DWGGATEWAY, and OPENDWG, and two in federal district court relating to Autodesk's TRUSTEDDWG mark and to the third-party mark OPENDWG. *See* Doc. No. 43 at

28. According to Autodesk, these efforts have resulted in competitors relinquishing the right to registrations incorporating DWG. *Id.* But nowhere in the record does it appear that these resolutions were based on the merits of Autodesk's underlying claims; and those settlements could have been motivated by a wide range of factors other than an acknowledgment that DWG, standing alone, constitutes in consumer perception an Autodesk product. *See* Doc. No. 50 at 24-25 (USPTO's noting that none of these actions seems to have involved a disposition in Autodesk's favor on the merits).⁶ Autodesk points out that it has obtained foreign trademark registrations for DWG and/or the DWG design mark; but "[e]vidence of registration in other countries is not legally or factually relevant to potential consumer perception of [the applicant's] goods in the United States." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 969 (Fed. Cir. 2007).

(6) The length and exclusivity of the mark's use

Autodesk also relies on its attaching a trademark symbol to DWG beginning in 2006; that since at least 2003, Autodesk has presented a distinctive file icon (which since 2005 has been the DWG design mark) on the computer screen of users of software products that feature DWG technology; and that since at least 1996, Autodesk has used DWG-related marks in promotional materials. Autodesk also has published a list of trademarks on its website and "DWG" is included on that list. Autodesk also licenses third-party software developers the ability to integrate DWG technology into their products together with the right to use Autodesk's DWG

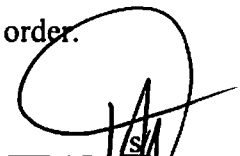
⁶ *See also* TTAB Opinion at 28 (finding that "[w]ith respect to the two district court actions, the papers submitted from the action against Dassault Systemes Solidworks Corporation do not reflect a victory for appellant [Autodesk] in the proceeding. The papers from the district court action against the Open Design Alliance reflect a settlement of the action, which did not involve the proposed mark DWG, but involved 'trademark infringement and false designation of origin based on [Open Design Alliance's] improper simulation of Autodesk's TrustedDWGTM authentication mechanism and use of the AUTODESK® trademark. . .").

logo. None of these facts are sufficient to establish that DWG has acquired the necessary secondary meaning. They may reflect Autodesk's efforts to claim or establish a secondary meaning, but the record is insufficient to establish that a secondary meaning has, in fact, been obtained; and the motivation of software developers to enter into licensing agreements, like settling litigants, may be completely unrelated to any acknowledgment that DWG, standing alone, is perceived by consumers as an Autodesk product.

IV. Conclusion

For the above reasons, the Court finds and concludes that Autodesk has not made a *prima facie* case of distinctiveness. The Court therefore finds and concludes that Autodesk is not entitled to trademark protection with respect to the marks included within the DWG Application. The Court will GRANT the USPTO's Motion for Summary Judgment, DENY Autodesk's Motion for Summary Judgment and enter judgment in favor of defendant USPTO.

The Court will issue an appropriate order.



Anthony J. Trenga
United States District Judge

Alexandria, Virginia
October 30, 2014

Exhibit 8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Autodesk, Inc.,

Petitioner,

v.

3D Systems, Inc.,

Respondent.

Cancellation No. 92056509

**PETITIONER AUTODESK'S RESPONSES TO
RESPONDENT 3D SYSTEMS' FIRST SET OF INTERROGATORIES**

Pursuant to Federal Rule of Civil Procedure 33 and the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Petitioner Autodesk, Inc. ("Autodesk"), by and through its undersigned counsel, hereby responds to the First Set of Interrogatories ("Interrogatories") by Respondent 3D Systems, Inc. as follows:

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Autodesk has not completed its investigation in this matter. All responses to the Interrogatories are based upon the information presently known to Autodesk and are given without prejudice to Autodesk's right to adduce evidence discovered or analyzed subsequent to the date of these responses. Autodesk expressly reserves the right to revise and supplement its responses to the Interrogatories in the event that its continuing investigation of the facts and/or discovery bring to light any additional information responsive to the Interrogatories.

GENERAL OBJECTION NO. 2:

Autodesk objects to the Interrogatories, and to each and every individual interrogatory, to the extent they seek information protected by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or protection. Without prejudice to this objection,

Autodesk will provide responses to the Interrogatories to the extent that such responses do not waive such privileges or protections.

GENERAL OBJECTION NO. 3:

Autodesk objects to the Interrogatories, including, but not limited to, the “Definitions” therein, and to each and every individual interrogatory, to the extent they purport to impose duties on Autodesk that are greater than those imposed by the Federal Rules of Civil Procedure and/or the TBMP.

GENERAL OBJECTION NO. 4:

Autodesk objects to the Interrogatories, and to each and every individual interrogatory, to the extent they seek information outside of Autodesk’s possession, custody, or control, on the grounds that any such interrogatory is overbroad and unduly burdensome, seeks to impose discovery obligations in excess of those imposed by the Federal Rules of Civil Procedure and/or the TBMP, and would subject Autodesk to unreasonable annoyance, burden, and expense.

GENERAL OBJECTION NO. 5:

Autodesk objects to the Interrogatories, and to each and every individual interrogatory, as unduly burdensome, oppressive and in violation of the Federal Rules of Civil Procedure and/or the TBMP to the extent they purport to require Autodesk to respond on behalf of, or conduct any inquiry or investigation with respect to, any party other than Autodesk. Autodesk will only answer the Interrogatories on its own behalf.

GENERAL OBJECTION NO. 6:

Autodesk objects to the Interrogatories, and to each and every individual interrogatory, to the extent they seek information that is neither admissible nor reasonably calculated to lead to the discovery of admissible evidence.

GENERAL OBJECTION NO. 7:

Autodesk objects to the Interrogatories, and to each and every individual interrogatory, as overbroad and unduly burdensome to the extent they do not include a limitation or proposed definition of a relevant time period.

GENERAL OBJECTION NO. 8:

Autodesk objects to the Interrogatories, and to each and every individual interrogatory, to the extent they are not consistent with or do not meet the requirements of Federal Rule of Civil Procedure 33 or the TBMP.

GENERAL OBJECTION NO. 9:

Autodesk specifically reserves all objections as to the competence, relevancy, materiality, and admissibility of its documents and interrogatory responses or the subject matter thereof, and all rights to object on any ground to the use of any document or interrogatory response, or the subject matter thereof, in any subsequent proceeding, including without limitation the trial of this or any action.

GENERAL OBJECTION NO. 10:

Autodesk objects to the Interrogatories, and to each and every individual interrogatory contained therein, to the extent they seek confidential or proprietary information pertaining to Autodesk's business, trade secrets and/or economic relationships ("Trade Secret Information"). To the extent such information is responsive to these Interrogatories and within the proper scope of discovery in this action, Autodesk will provide such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board. Autodesk objects to producing Trade Secret Information before the execution of such a protective order and approval of such a Protective Order by the Trademark Trial and Appeal Board.

Autodesk expressly incorporates the above General Objections as though set forth fully in response to each of the following individual interrogatories, and, to the extent they are not raised in any particular response, Autodesk does not waive those objections. An answer to an interrogatory shall not be deemed a waiver of any applicable specific or general objection to an interrogatory. Likewise, an answer to an interrogatory shall not be deemed an admission of any assertions contained in that interrogatory.

RESPONSES

INTERROGATORY NO. 1:

Identify the three persons who are the most knowledgeable concerning the use of the 3DS MAX Mark by Autodesk and/or its Licensees in the United States, including the date of first use, and the products and services sold and/or provided, or to be sold or provided, under the 3DS MAX Mark.

RESPONSE TO INTERROGATORY NO. 1:

Autodesk objects to this request, and particularly to the request for identification of three persons, on the grounds that it is unduly burdensome.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: the individual most knowledgeable concerning the use of the 3DS MAX Mark by Autodesk is Maurice Patel, Sr. Manager, Media & Entertainment, Industry Marketing for Autodesk.

INTERROGATORY NO. 2:

Identify each of Autodesk's related companies, as well as each predecessor or successor in interest of Autodesk, insofar as the business or interest of such related company pertains to any use of the 3DS MAX Mark in the United States.

RESPONSE TO INTERROGATORY NO. 2:

Autodesk objects to this request as vague and ambiguous on the grounds that the terms “related,” “interest” and “pertains” are unclear and not defined. Autodesk objects to this request on the grounds that it is overbroad and unduly burdensome.

Subject to and without waiving the General Objections and specific objections above, Autodesk, pursuant to Federal Rule of Civil Procedure 33(d), will produce non-privileged documents that are responsive to the request after a reasonable search.

INTERROGATORY NO. 3:

If Autodesk now has, or ever had, any agreement, either written or oral, concerning any use or non-use of the 3DS MAX Mark, then, for each such agreement or understanding, identify all parties to the agreement, including all persons participating in its creation, and state the nature and substance of the agreement and the circumstances which led to its existence.

RESPONSE TO INTERROGATORY NO. 3:

Autodesk objects to this interrogatory on the grounds that it is vague, overly broad and unduly burdensome. Autodesk further objects to this request on the grounds that it calls for disclosure of highly sensitive commercial information and/or trade secrets subject to contractual or other confidentiality restrictions.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: Autodesk is not party to any licenses or other agreements directed specifically at the use of the trademark 3DS MAX. Autodesk, as a software manufacturer, is party to thousands of agreements with training centers, distributors and other channel partners permitting them to market and/or sell licenses to Autodesk products, including products bearing the 3DS MAX trademark; to the extent this interrogatory calls for disclosure of the requested information concerning all such agreements, it is patently improper.

INTERROGATORY NO. 4:

State all ways in which Autodesk (or any of its Licensees) has used the 3DS MAX Mark in the United States (including an identification of all materials on which said mark has been used), and identify when each such use began.

RESPONSE TO INTERROGATORY NO. 4:

Autodesk objects to this request on the grounds that it is overbroad and unduly burdensome.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: Since at least as early as January 22, 2001, Autodesk and its licensees have displayed the 3DS MAX Mark on discs and product packaging, and they have also displayed the mark in advertising and promotional material, including on Autodesk's primary website located at <autodesk.com>, and at trade shows.

INTERROGATORY NO. 5:

(a) Identify with particularity each different type of product and service ever offered for sale or sold in the United States by Autodesk (or its Licensees) under the 3DS MAX Mark.

(b) Separately for each type of product and service identified in response to Interrogatory No. 5(a), state in detail:

(i) the date on which Autodesk (or its Licensees) commenced offering for sale or selling each such type of product or service under said mark in this country;

(ii) the date on which Autodesk (or its Licensees) ceased offering for sale, selling or otherwise using the 3DS MAX Mark in connection with each such type of product or service in the United States;

(iii) the classes or types of customers in this country who purchased (or will be targeted as purchasers) directly from Autodesk (or its Licensees) each such type of product or service;

(iv) the channels of trade through which each product or service is offered for sale;

(v) the manner in which the 3DS Max Mark has been used in the United States in connection with each type of product or service and its promotion; and

(vi) the gross sales revenue generated annually by sales of such goods and services in this country by Autodesk and its Licensees, for each calendar year in which such goods or services have been sold, including, without limitation, that portion of the current year.

RESPONSE TO INTERROGATORY NO. 5:

Autodesk objects to this request as compound. Autodesk objects to this request as overly broad and unduly burdensome.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: Since at least as early as January 22, 2001, Autodesk has offered for sale computer software for animating, modeling and rendering images, under marks containing the 3DS MAX Mark. Said marks include, but are not limited to: 3DS MAX 4.0, 3DS MAX 4.3, 3DS MAX 5.0, 3DS MAX 5 DISCREET, 3DS MAX 6 DISCREET, 3DS MAX 7, 3DS MAX 7 DISCREET, 3DS MAX 8, 3DS MAX 9, 3DS MAX 2008, 3DS MAX 2009, 3DS MAX DESIGN 2009, 3DS MAX 2010, 3DS MAX DESIGN 2010, 3DS MAX ENTERTAINMENT CREATION SUITE 2010, 3DS MAX REAL-TIME ANIMATION SUITE 2010, 3DS MAX 2011, 3DS MAX DESIGN 2011, 3DS MAX ENTERTAINMENT CREATION SUITE 2011, 3DS MAX 2012, 3DS MAX DESIGN 2012, 3DS MAX ENTERTAINMENT CREATION SUITE STANDARD 2012, 3DS MAX ENTERTAINMENT CREATION SUITE PREMIUM 2012, 3DS MAX 2013, 3DS MAX DESIGN 2013, 3DS MAX ENTERTAINMENT CREATION SUITE STANDARD 2013 and 3DS MAX ENTERTAINMENT CREATION SUITE PREMIUM 2013. The classes of consumers for products bearing the 3DS MAX Mark include developers of computer games and films as well as motion graphic artists. Software licenses for products bearing the 3DS MAX Mark are purchased directly from Autodesk and from authorized distributors, channel partners and training centers.

INTERROGATORY NO. 6:

Identify the three persons most knowledgeable about the sales and distribution of products or services sold by Autodesk in connection with the 3DS MAX Mark.

RESPONSE TO INTERROGATORY NO. 6:

Autodesk objects to this request, and particularly to the request for identification of three persons, on the grounds that it is unduly burdensome.

Subject to and without waiving the General Objections above, Autodesk responds: The individual most knowledgeable about the sales and distribution of products or services sold by Autodesk in connection with the 3DS MAX Mark is Maurice Patel, Sr. Manager, Media & Entertainment, Industry Marketing for Autodesk.

INTERROGATORY NO. 7:

Identify each person whom Autodesk may call as a fact witness on its behalf in this proceeding, and state, for each such witness, the expected subject matter, substance and foundation of and for his or her testimony.

RESPONSE TO INTERROGATORY NO. 7:

Autodesk objects to this request on the ground that it calls for information protected by the attorney-client privilege and/or attorney work product doctrines. Autodesk further objects to this request on the grounds that it is overbroad and unduly burdensome. Autodesk objects to this request as compound.

INTERROGATORY NO. 8:

Identify each person Autodesk may call as an expert witness on its behalf in this proceeding, and for each such person, state the basis for his or her qualification as an expert, the subject matter on which he or she is expected to give testimony, the substance of the facts and opinions to which he or she is expected to give testimony, and any reports prepared by each expert.

RESPONSE TO INTERROGATORY NO. 8:

Autodesk objects to this request on the ground that it calls for information protected by the attorney-client privilege and/or attorney work product doctrines. Autodesk further objects to this request on the grounds that it is unduly burdensome.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: Autodesk has not yet decided which experts, if any, on which it will rely in this proceeding. Autodesk will supplement its response if necessary.

INTERROGATORY NO. 9:

Identify all Licensees, and any other third parties authorized by Autodesk to market, sell, offer for sale, or distribute goods or services under the 3DS MAX Mark.

RESPONSE TO INTERROGATORY NO. 9:

Autodesk objects to this request on the grounds that it is overly broad and unduly burdensome. Autodesk further objects to this request on the grounds that it calls for disclosure of highly sensitive commercial information and/or trade secrets subject to contractual or other confidentiality restrictions. Autodesk objects to this request as compound.

Subject to and without waiving the General Objections above, Autodesk responds: Autodesk is not party to any licenses or other agreements directed specifically at the use of the trademark 3DS MAX. Autodesk, as a software manufacturer, is party to thousands of agreements with training centers, distributors and other channel partners permitting them to market and/or sell licenses to Autodesk products, including products bearing the 3DS MAX trademark.

INTERROGATORY NO. 10:

Identify each instance known to Autodesk of use of any marks incorporating the term "3DS" by any other person or entity and with respect to each such instance of use, specify:

- (a) the manner of use;
- (b) when Autodesk first became aware of such use, and the means by which

Autodesk became aware of such use;

(c) identify any steps taken by Autodesk to enforce the rights it claims in the 3DS MAX Mark against such use; and

(d) identify the persons who have knowledge of such use, or reported such use to Autodesk.

RESPONSE TO INTERROGATORY NO. 10:

Autodesk objects to this request on the grounds that it is overbroad and unduly burdensome. Autodesk objects to this request on the ground that it seeks information related to uses of marks consisting of or containing 3DS that occurred outside the United States. Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine. Autodesk objects to this request as compound.

INTERROGATORY NO. 11:

Identify any and all efforts Autodesk has made to enforce the rights it claims in the 3DS MAX Mark.

RESPONSE TO INTERROGATORY NO. 11:

Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine. Autodesk objects to this request Autodesk objects to this request as vague and ambiguous on the grounds that the term “efforts” is undefined and unclear.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: Autodesk has initiated Uniform Domain Name Resolution Proceedings for the recovery of the domain names <3ds-max.com>, <autodesk3dmax.com> and <3dsmax3d.com>. Autodesk has also initiated adversary proceedings before the Trademark Trial and Appeal Board at the U.S. Patent and Trademark Office concerning federal trademark applications for marks similar to 3DS MAX, including against Position Imaging, Inc. (opposition no. 91189720; opposition sustained) and Dassault Systemes S. A. (opposition no. 91158625; application abandoned). Moreover, Autodesk has persuaded third parties to abandon federal

trademark applications for similar marks, including application serial no. 77339008 owned by Cognex Corporation.

INTERROGATORY NO. 12:

Identify the three persons who are most knowledgeable about Autodesk's enforcement of the rights it claims in the 3DS MAX Mark.

RESPONSE TO INTERROGATORY NO. 12:

Autodesk objects to this request, and particularly to the request for identification of three persons, on the grounds that it is unduly burdensome. Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving the General Objections or specific objections above, Autodesk responds: The individual most knowledgeable about Autodesk's enforcement of the rights it claims in the 3DS MAX Mark is Lisa Turbis, Corporate Counsel for Autodesk.

INTERROGATORY NO. 13:

Identify each instance of which Autodesk has actual or hearsay knowledge, directly or indirectly, or any actual or purported association or confusion of any type between Autodesk (or its Licensees) and/or its products and services sold in connection with the 3DS MAX Mark, on the one hand, and 3D Systems and/or its products and services sold in connection with the 3DS & Design Mark, on the other hand.

RESPONSE TO INTERROGATORY NO. 13:

Autodesk objects to this request to the extent that it calls for legal conclusions. Autodesk objects to this request on the ground that its investigation is ongoing, and accordingly it is premature to respond to this request.

INTERROGATORY NO. 14:

Identify the persons who are most knowledgeable about the adoption or use of the 3DS & Design Mark by 3D Systems, and describe with particularity the circumstances under which Autodesk first became aware of the 3DS & Design Mark.

RESPONSE TO INTERROGATORY NO. 14:

Autodesk objects to this request as compound. Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

INTERROGATORY NO. 15:

Set forth each and every factual basis for Autodesk's contention that the 3DS MAX Mark is confusingly similar to the 3DS & Design Mark.

RESPONSE TO INTERROGATORY NO. 15:

Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine. Autodesk further objects to this request to the extent that it calls for legal conclusions. Autodesk objects to this request on the ground that its investigation is ongoing, and accordingly it is premature to respond to this request.

INTERROGATORY NO. 16:

Identify the annual expenditures of Autodesk and its Licensees on the marketing and promotion of goods and services offered under the 3DS MAX Mark in the United States.

RESPONSE TO INTERROGATORY NO. 16:

Autodesk objects to this request on the grounds that it calls for disclosure of highly sensitive commercial information and/or trade secrets.

Subject to and without waiving the General Objections or specific objections above, Autodesk responds: Autodesk does not track annual marketing and promotion expenditures data by product or service, such as those under the 3DS MAX Mark.

INTERROGATORY NO. 17:

Identify the three persons most knowledgeable about the advertising and promotion of goods and services offered by you under the 3DS MAX Mark.

RESPONSE TO INTERROGATORY NO. 17:

Autodesk objects to this request, and in particular to the request for identification of three persons, on the grounds that it is unduly burdensome.

Subject to and without waiving the General Objections above, Autodesk responds: The individual that is most knowledgeable about the advertising and promotion of goods and services offered by Autodesk under the 3DS MAX Mark is Maurice Patel, Sr. Manager, Media & Entertainment, Industry Marketing for Autodesk.

INTERROGATORY NO. 18:

Identify the earliest date on which Autodesk contends that it commenced use of the 3DS MAX Mark in commerce in the United States.

RESPONSE TO INTERROGATORY NO. 18:

Autodesk objects to this request to the extent that it calls for legal conclusions.

Subject to and without waiving the General Objections and specific objection above, Autodesk responds: Autodesk commenced use of the 3DS MAX Mark in commerce in the United States on or before January 22, 2001.

INTERROGATORY NO. 19:

Identify the earliest date on which Autodesk contends that it commenced use of any mark containing the term "3DS" in commerce in the United States.

RESPONSE TO INTERROGATORY NO. 19:

Autodesk objects to this request to the extent that it calls for legal conclusions.

Subject to and without waiving the General Objections and specific objection above, Autodesk responds: Autodesk any mark containing the term "3DS" in commerce in the United States on or before January 22, 2001.

INTERROGATORY NO. 20:

Identify the three person(s) most knowledgeable about the creation, selection and decision by Autodesk (and/or its predecessors) to adopt the 3DS MAX Mark, and identify all documents related to the creation, selection and adoption of the 3DS MAX Mark, including but not limited to search reports and opinions, advertising agency, marketing or public relations firm documents, and internal memoranda and emails.

RESPONSE TO INTERROGATORY NO. 20:

Autodesk objects to this request, and in particular to the request for identification of three persons, on the grounds that it is unduly burdensome. Autodesk objects to this request as compound. Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

INTERROGATORY NO. 21:

Explain the use of the term “MAX” in the 3DS MAX Mark, including, without limitation, what it signifies, how it was created, and/or how it came to be used, as a component thereof.

RESPONSE TO INTERROGATORY NO. 21:

Autodesk objects to this request as vague and ambiguous on the grounds that meaning of the phrases “how it was created” and “how it came to be used” in this context are unclear.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: “MAX” in the 3DS MAX Mark signifies “maximum.”

INTERROGATORY NO. 22:

Identify the three person(s) most knowledgeable about the adoption of “.3ds” as a filename extension by Autodesk, its Licensees, or any third party.

RESPONSE TO INTERROGATORY NO. 22:

Autodesk objects to this request, and in particular to the request for identification of three persons, on the grounds that it is unduly burdensome. Autodesk further objects to this request on the ground that it calls for information not relevant to the claims or defenses in this proceeding.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: The individual that is most knowledgeable about the adoption of “.3ds” as a filename extension by Autodesk is Chris Young, VP Engineering, Media & Entertainment, for Autodesk.

INTERROGATORY NO. 23:

Describe the nature of the “.3ds” filename extension, including, without limitation, what it signifies, what goods it may be used in connection with, who may use it, and what software programs recognize it.

RESPONSE TO INTERROGATORY NO. 23:

Autodesk objects to this request on the ground that it calls for information not relevant to the claims or defenses in this proceeding.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: the “.3ds” filename extension can be used for exporting files created or viewed in Autodesk’s 3DS MAX-related software products.

INTERROGATORY NO. 24:

Identify any studies, tests, polls or surveys related to consumer recognition of the 3DS MAX Mark.

RESPONSE TO INTERROGATORY NO. 24:

Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: Autodesk has not conducted any studies, tests, polls or surveys related to consumer recognition of the 3DS MAX Mark.

INTERROGATORY NO. 25:

As to each Request for Admission that you did not admit, explain the basis for your refusal to admit the matter.

RESPONSE TO INTERROGATORY NO. 25:

Autodesk objects to the request to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine. Autodesk objects to this request as compound.

Dated: January 27, 2014

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By:  

John L. Slafsky

Attorneys for Petitioner
AUTODESK, INC.

CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California, 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I caused to be personally served **PETITIONER AUTODESK'S RESPONSES TO RESPONDENT 3D SYSTEMS' FIRST SET OF INTERROGATORIES** on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I placed the envelope(s) for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on January 27, 2014.


Elvira Minjarez

Exhibit 9

AUTODESK PRIVILEGE LOG

CONFIDENTIAL

TAB	Date	TO	FROM	CC	Doc Type	Description	Privilege Claim
1	7/21/2003	Christine Kalb	Michael Hughes		letter	outside counsel legal advice to company	AC
2	5/8/2001	Christine Kalb	Michael Hughes		letter	outside counsel legal advice to company	AC
3	10/26/2012	Jennifer Daehler	Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
4	12/19/2012	Jennifer Daehler, Michael Hughes	Michael Hughes, Jennifer Daehler	Holly Ross, Michael Hughes, Vivian Emberley	email	outside counsel legal advice to company	AC
5	8/10/2006 - 8/16/2006	Rich Foehr, Michael Hughes	Michael Hughes, Rich Foehr	Christine Kalb, Jennifer Daehler, Michael Hughes	email	outside counsel legal advice to company	AC
6	8/10/2006 - 8/15/2006	Rich Foehr, Michael Hughes	Michael Hughes, Rich Foehr	Christine Kalb, Jennifer Daehler, Michael Hughes	email	outside counsel legal advice to company	AC
7	8/10/2006	Rich Foehr	Michael Hughes	Christine Kalb, Jennifer Daehler, Michael Hughes	email	outside counsel legal advice to company	AC
8	5/26/2006 - 5/30/2006	Rich Foehr, Michael Hughes	Michael Hughes, Rich Foehr	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
9	5/25/2006 - 5/26/2006	Rich Foehr, Michael Hughes	Michael Hughes, Rich Foehr	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC

AUTODESK PRIVILEGE LOG

CONFIDENTIAL

TAB	Date	TO	FROM	CC	Doc Type	Description	Privilege Claim
10	5/25/2006	Michael Hughes, Pascal Di Fronzo, Rich Foehr, Lisa Turbis, Lisa Mango	Rich Foehr, Ruth Ann Keene	Christine Kalb, Jennifer Daehler	email	outside counsel legal advice to company	AC
11	12/30/2005	Rich Foehr, Michael Hughes	Michael Hughes, Rich Foehr	Michael Hughes	email	outside counsel legal advice to company	AC
12	7/21/2005	Rich Foehr, Christine			handwritten notes	outside counsel legal advice to company	AC/WP
13	2/20/2005	Rich Foehr	Michael Hughes	Michael Hughes, Vivian Emberley, Christine Kalb	email	outside counsel legal advice to company	AC
14	2/27/2005 - 3/1/2005	Rich Foehr, Michale Hughes, Christine Kalb	Michael Hughes, Rich Foehr	Michael Hughes, Christine Kalb	email	outside counsel legal advice to company	AC
15	2/15/2005 - 3/27/2005	Rich Foehr, Michale Hughes, Christine Kalb	Michael Hughes, Rich Foehr	Michael Hughes, Vivian Emberley	email	outside counsel legal advice to company	AC
16	2/15/2005 - 3/24/2005	Rich Foehr, Christine Kalb	Michael Hughes	Michael Hughes, Vivian Emberley	email	outside counsel legal advice to company	AC
17	10/11/2004	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Vivian Emberley, Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
18	10/11/2004	Rich Foehr	Michael Hughes	Vivian Emberley, Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
19	7/14/2004	Michael Hughes, Christine Kalb	Christine Kalb, Michael Hughes	Rich Foehr, Michael Hughes	email	outside counsel legal advice to company	AC
20	7/14/2004	Christine Kalb	Michael Hughes	Rich Foehr, Michael Hughes	email	outside counsel legal advice to company	AC

AUTODESK PRIVILEGE LOG

CONFIDENTIAL

TAB	Date	TO	FROM	CC	Doc Type	Description	Privilege Claim
21	6/15/2004	Michael Hughes	Rich Foehr	Vivian Emberley	email	outside counsel legal advice to company	AC
22	6/15/2004	Christine Kalb	Michael Hughes	Michael Hughes, Vivian Emberley	email	outside counsel legal advice to company	AC
23	4/5/2004	Michael Hughes, Rich Foehr, Christine Kalb	Christine Kalb, Michael Hughes	Michael Hughes	email	outside counsel legal advice to company	AC
24	4/5/2004	Rich Foehr, Christine Kalb	Michael Hughes	Michael Hughes	email	outside counsel legal advice to company	AC
25	1/29/2004 - 2/2/2004	Rich Foehr, Michael Hughes	Michael Hughes, Rich Foehr	Michael Hughes, Christine Kalb	email	outside counsel legal advice to company	AC
26	1/29/2004 - 1/30/2004	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
27	1/29/2004	Rich Foehr	Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
	1/29/2004				text document	outside counsel legal advice to company	AC/WP
28	1/15/2004 - 1/16/2004	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
29	1/15/2004	Rich Foehr	Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
30	11/13/2003	Michael Hughes	Christine Kalb	Rich Foehr, Javier Martell	email	outside counsel legal advice to company	AC
31	9/18/2003 - 10/26/2003	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
32	9/18/2003 - 10/24/2003	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
33	9/18/2003 - 10/14/2003	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
34	9/18/2003 - 10/14/2003	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC

AUTODESK PRIVILEGE LOG

CONFIDENTIAL

TAB	Date	TO	FROM	CC	Doc Type	Description	Privilege Claim
35	9/18/2003 - 10/3/2003	Rich Foehr	Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
36	10/3/2004	Michael Hughes, Rich Foehr	Christine Kalb, Michael Hughes	Rich Foehr, Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
37	9/18/2003	Rich Foehr	Michael Hughes	Christine Kalb, Michael Hughes	email	outside counsel legal advice to company	AC
38	5/26/2004		Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
39	8/10/2006		Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
40	7/24/2006		Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
41	12/30/2005	Rich Foehr	Michael Hughes	Michael Hughes	email	outside counsel legal advice to company	AC

AUTODESK PRIVILEGE LOG

CONFIDENTIAL

TAB	Date	TO	FROM	CC	Doc Type	Description	Privilege Claim
42	12/29/2005		Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
43	3/1/2005		Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
44	10/24/2003 - 10/27/2003		Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
45	10/14/2003		Michael Hughes		handwritten notes	outside counsel legal advice to company	AC/WP
46	6/11/1013	Holly Ross, Jennifer Daehler	Michael Hughes	Vivian Emberley, Michael Hughes	email	outside counsel legal advice to company	AC
47	7/21/2003	Christine Kalb	Michael Hughes		letter	outside counsel legal advice to company	AC
48	7/12/2012	Holly Ross	Michael Hughes		letter	outside counsel legal advice to company	AC
					text document	outside counsel legal advice to company	AC

AUTODESK PRIVILEGE LOG

CONFIDENTIAL

TAB	Date	TO	FROM	CC	Doc Type	Description	Privilege Claim
49	7/12/2012	Holly Ross	Michael Hughes		letter	outside counsel legal advice to company	AC
					text document	outside counsel legal advice to company	AC
50	12/19/2012	Jennifer Daehler, Michael Hughes	Michael Hughes, Jennifer Daehler	Holly Ross, Michael Hughes, Vivan Emberley	email	outside counsel legal advice to company	AC
51	12/20/2005	Michael Hughes, Rich Foehr	Rich Foehr, Michael Hughes	Michael Hughes	email	outside counsel legal advice to company	AC